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12 MICROSOFT CORPORATION

13 UNITED STATES DISTRICT COURT  
14 NORTHERN DISTRICT OF CALIFORNIA  
15 OAKLAND DIVISION  
16

17 INTERTRUST TECHNOLOGIES  
CORPORATION, a Delaware corporation,

18 Plaintiff,

19 v.  
20

21 MICROSOFT CORPORATION, a  
Washington corporation,

22 Defendant.  
23

24 AND RELATED CROSS-ACTION.  
25  
26  
27  
28

Case No. C 01-1640 SBA (MEJ)

Consolidated with C 02-0647 SBA (MEJ)

**DEFENDANT MICROSOFT  
CORPORATION'S PRELIMINARY  
INVALIDITY CONTENTIONS**

(Patent Local Rules 3-3 and 3-4)

1     **I.     Patent Local Rule 3-3(a) Identification of Prior Art**

2             Pursuant to Patent Local Rule 3-3, Defendant Microsoft Corporation ("Microsoft") makes  
3     the following Preliminary Invalidity Contentions<sup>1</sup> with respect to the following patents asserted  
4     by plaintiff InterTrust Technologies Corporation ("InterTrust") in this action: U.S. Patent No.  
5     6,185,683 ("the '683 patent"); U.S. Patent No. 6,253,193 ("the '193 patent"); U.S. Patent No.  
6     5,920,861 ("the '861 patent"); U.S. Patent No. 5,982,891 ("the '891 patent"); U.S. Patent No.  
7     5,917,912 ("the '912 patent"); U.S. Patent No. 6,157,721 ("the '721 patent"); U.S. Patent No.  
8     5,915,019 ("the '019 patent"); U.S. Patent No. 5,949,876 ("the '876 patent"); U.S. Patent No.  
9     6,112,181 ("the '181 patent"); and U.S. Patent No. 6,389,402 ("the '402 patent").

10            Despite the length of time this case has been pending, discovery is still at an early stage  
11     due to intervening stays. InterTrust continues to assert eleven patents and over one hundred and  
12     fifty claims. In view of these factors, Microsoft continues to evaluate the prior art at this time.  
13     Microsoft reserves the right to amend or supplement its Preliminary Invalidity Contentions to take  
14     into account prior art, information or defenses that might come to light as a result of its  
15     continuing discovery efforts, errors subsequently recognized by any of the parties, and as a result  
16     of further evaluation of the prior art.<sup>2</sup> In addition, Microsoft has moved to strike InterTrust's  
17     September 2, 2003 PLR 3-1 Preliminary Infringement Contentions as being insufficient. To the  
18     extent that the Court grants Microsoft's motion and orders InterTrust to amend/re-serve its 3-1  
19     statement in compliance with the Local Rules, Microsoft reserves the right to amend or  
20     supplement its PLR 3-3 Preliminary Invalidity Contentions in response to any amended  
21     infringement contentions submitted by InterTrust. Microsoft further reserves the right to rely

22     <sup>1</sup> These Preliminary Invalidity Contentions incorporate by reference Microsoft's prior Preliminary  
23     Invalidity Contentions dated August 7 and 16, 2002.

24     <sup>2</sup> For example, Microsoft reserves the right to amend/supplement this disclosure once InterTrust  
25     complies with discovery responses, which Microsoft contends are incomplete and inadequate. To  
26     date, Microsoft has objected to InterTrust's continued refusal to provide information sought in  
27     discovery, including, but not limited to: the identity of the alleged inventors of specific claims;  
28     conception or actual reduction to practice dates for specific claims; whether to there has ever been  
any alleged embodiment(s) of the asserted claims; and what, if any, specification support is  
alleged, including from any of the applications for which InterTrust claims priority.

Each of these pieces of information could affect the priority date for any given claim, expanding  
or narrowing the window of applicable prior art. Without this information, which is within  
InterTrust's exclusive knowledge and control, Microsoft's PLR 3-3 Contentions are subject to  
amendment and/or supplementation.

1 upon InterTrust's own activities, alone and in connection with others. Microsoft further reserves  
2 the right to amend this statement or otherwise further respond if InterTrust contends (or the Court  
3 rules) that any earlier or later priority dates may apply for individual claims. Microsoft also  
4 reserves its right to amend or supplement these invalidity contentions pursuant to Patent Local  
5 Rule 3-6 and 3-7.

6 Attached hereto, as Appendix A, is a listing showing "the identity of each item of prior art  
7 that allegedly anticipates each asserted claim or renders it obvious" (PLR 3-3(a)). On information  
8 and belief, each listed publication became prior art at least as early as the dates given. In  
9 addition, the citations and explanations provided in the exhibits are mere examples, and Microsoft  
10 reserves its right to rely on any other portions or aspects of the prior art references and systems  
11 that may also disclose or practice elements of the asserted claims. Patent Local Rule 3-3 does not  
12 require identification of evidence that establishes the inherence of a claim element in an item of  
13 prior art, nor does it require identification of evidence that establishes knowledge of those of  
14 ordinary skill in the relevant fields of art. Accordingly, Microsoft does not purport to have  
15 provided all such information in the attached exhibits.

16 From InterTrust's current document production, it appears that its employees' and  
17 consultants' activities, including offers for sale, public uses, derivations, "inventions" (as the  
18 word is used in 35 U.S.C. § 102(g)), and disclosures to Willis Ware, Drew Dean, and others not  
19 under any duty of confidentiality, constituted or created material and perhaps anticipatory prior  
20 art to many of the asserted claims. This art was not cited to the Patent Office. Discovery is  
21 ongoing, and Microsoft reserves the right to amend or supplement this disclosure after Microsoft  
22 has had an opportunity to investigate this possible prior art during discovery.

## 23 II. Patent Local Rule 3-3(b) and 3-3 (c) Classification and Analysis of Prior Art

24 Microsoft contends that at least one term or phrase in each of the asserted claims is  
25 indefinite under 35 U.S.C. § 112, and hence, each of the asserted claims is incapable of  
26 construction. However, for the limited purpose of classification and analysis of prior art,  
27 Microsoft has construed the claim terms in a manner consistent with the apparent construction of  
28 terms offered by InterTrust in its Revised Preliminary Infringement Contentions. Microsoft does

1 not agree with these constructions, and nothing in these Preliminary Invalidity Contentions  
2 should be construed as an admission, a declaration against interest, whether under the  
3 Federal Rules of Evidence or otherwise, as to what a particular claim limitation means. For  
4 this reason, Microsoft's identification of "corresponding structures" for "means-plus-  
5 function" limitations that are set out in the Preliminary Invalidity Charts are not  
6 admissions as to the identity of such structures. Rather, they are based upon Microsoft's best  
7 guess as to what InterTrust may someday identify as corresponding structures for the means-plus-  
8 function limitations of its asserted claims, to the extent that Microsoft understands them.<sup>3</sup>

9 Accordingly, Microsoft's Preliminary Invalidity Contentions should not be construed as  
10 advocating a particular claim construction for any disputed claim terms. For the limited purpose  
11 of providing Preliminary Invalidity Contentions, and subject to the conditions set forth above,  
12 Microsoft has, to the extent possible, attempted to construe the claims in a manner consistent with  
13 InterTrust's Revised Preliminary Infringement Contentions.

14 Pursuant to Patent Local Rules 3-3(b) and 3-3(c), Microsoft provides the classification of  
15 prior art in the listing and charts attached hereto as Appendices A and B. Appendix A, beyond  
16 identifying each item of prior art, further indicates whether each prior art reference is used as an  
17 anticipatory reference and/or as a reference which, alone, or in combination with other prior art,  
18 renders the claims obvious. Appendix B includes charts which (1) specifically identify where in  
19 each item of prior art each element of each asserted claim is found and (2) establish how that  
20 prior art anticipates or renders obvious all of the asserted claims. In the event that any charted  
21 prior art is found not to be anticipatory under 35 U.S.C. § 102, Microsoft reserves the right to rely  
22 upon that art to prove obviousness under 35 U.S.C. § 103. Likewise, in the event InterTrust  
23

24  
25 <sup>3</sup> To date, InterTrust has refused to identify any structure corresponding to the means-plus-  
26 function elements in its asserted claims. It is Microsoft's position that this is a violation of the  
27 Patent Local Rules, and that as a result of refusing to identify a structure associated with each  
28 means-plus-function element, InterTrust admits that there is no such structure disclosed, has  
waived its right to assert claimed structure, and that those claims are therefore invalid at least for  
failure to satisfy the written description requirement of 35 U.S.C. §112. See InterTrust's Patent  
Local Rule 3-1 served September 2, 2003 and InterTrust's Opposition to Microsoft's Motion to  
Strike InterTrust's PLR 3-1 Contentions.

1 amends or supplements its Preliminary Infringement Contentions, Microsoft reserves its rights to  
2 amend and supplement its Preliminary Invalidity Contentions.

3 To the extent that any prior art produced to InterTrust has not been classified as prior art  
4 under 35 U.S.C. §§ 102 or 103, Microsoft reserves the right to rely on this art or supplement its  
5 disclosure for the following reasons:

6 (i) Microsoft's position on the invalidity of particular claims will depend on how  
7 those claims are construed by the Court. As thus far only preliminary claim construction has  
8 occurred Microsoft cannot take a final position for the bases for invalidity of disputed claims:  
9 The Court's subsequent claim constructions of remaining terms may yield constructions different  
10 from what Microsoft assumes herein.

11 (ii) Microsoft is continuing to diligently search for relevant prior art but has not yet  
12 completed that search and continues to evaluate prior art that has been located.

13 (iii) Microsoft has not completed its discovery from Plaintiff or from third parties  
14 with knowledge of the relevant prior art. Depositions of the persons involved in the drafting and  
15 prosecution of the patents-in-suit, the inventors, and persons who attempted to practice  
16 InterTrust's claimed invention, for example, will likely affect Microsoft's contentions.

17 **A. Prior Art Under 35 U.S.C. § 102 Which Anticipates The Asserted Claims of**  
18 **Each of the Asserted Patents**

19 Subject to the above-referenced qualifications concerning the preliminary nature of this  
20 disclosure, Microsoft believes a reasonable basis exists that, as more particularly explained in the  
21 Preliminary Invalidity Contentions attached as Appendix B hereto, the references listed in  
22 Appendix B anticipate the asserted claims of the each of the asserted patents.

23 **B. Prior Art Under 35 U.S.C. § 103 Which Renders Obvious One or More of the**  
24 **Asserted Claims**

25 Each of the references called out in Appendix A can be combined with one another so as  
26 to render one or more of the claims of the asserted patents invalid as obvious, and many of them  
27 are explicitly motivated to do so by virtue of extensive cross-references to one another's  
28 solutions. InterTrust is currently asserting 151 claims in eleven patents, which cite hundreds of  
references. Hundreds of additional non-cited relevant prior art has been uncovered and cited to

1 InterTrust. The number of potential combinations of these references, if only two or a few  
2 references are combined for each claim, is necessarily very large. Microsoft requests InterTrust  
3 to reduce its asserted claims so as to reduce the number of combinations to a manageable number.  
4 Nonetheless, Microsoft has provided mapping of combinations as discussed below. Indeed, even  
5 where explicit cross-referencing and incorporation by reference does not exist, the motivation to  
6 combine any of the references arises from the common objectives and subject matter, digital  
7 rights management. The common objectives and subject matter are expressed generally in the  
8 claim charts of Appendix B, which are incorporated by reference into Microsoft's showing under  
9 35 U.S.C. § 103.

10 The motivation for seeking "security," privacy and integrity was widely recognized in the  
11 United States and elsewhere prior to February 13, 1994, and since prior to February 13, 1994, has  
12 extended to any information or item of perceived value, including books, music, games, computer  
13 systems, other computer programs, and any digital data or content that maybe deemed valuable or  
14 worthy of protection. Additional motivations to combine references include the desire to meet or  
15 exceed any applicable laws or industry or government standards, such as the Orange Book,  
16 Computer Fraud and Abuse Act of 1986, Computer Security Act of 1989 PL100-35, High  
17 Performance Computing Act (HPCA) of 1991 (PL102-194), and 17 U.S.C. §§ 101 et seq.  
18 Industry standards include those for communication such as X.509, TCP/IP, WWW, and WAIS,  
19 and those for encryption or transmission of encrypted information, *e.g.* DES, Triple DES, RSA,  
20 SSL, MIME, S/MIME, SHTTP, HTTPS, MD5, and PEM. Additional teachings to combine these  
21 references with such items of information include "security" (including "security" levels),  
22 permissions, certificates, tickets, "secure" processors, "secure" storage, "smart" cards (including  
23 smart cards able to store data and perform computations such as encryption/decryption), tamper  
24 resistance techniques for hardware and software, physical "security", and "trusted" time. Also  
25 included are authentication and authorization in trusted distributed systems, enabling software or  
26 features thereof to run only on particular machines or in particular ways, and treating binary  
27 information/data at varied levels of granularity.

1 It was further obvious to combine any of these "security" features with any of the software  
2 or hardware available at the time. For example, it would have been obvious to combine any file  
3 and operating systems such as NT, NFS, Andrew, Netware, Mach, DT Mach, Multics, Amoeba,  
4 ISOS, and Unix; or protocols, codes and systems such as secure kernels, WWW, SSL, SGML,  
5 hypertext, Oak, Telescript, OOP and other programming technologies or frameworks (e.g.  
6 Smalltalk, COM, OLE, Bento, OpenDoc; object oriented databases with watermarking;  
7 obfuscation; swiPe; SNMP; auditing; on-line (or other digitally transmitted) transaction and  
8 subscription-based services and billings; electronic payment; on-line banking, entertainment and  
9 commercial interactive commerce; ATMs; encryption and authentication; physical security tools  
10 and devices; physically secure locations; physically "secure" products such as tamper resistant  
11 computer or other devices, "secure" processors, "secure" memory, "smart" cards, set-top boxes,  
12 portable devices, "secure" communications facilities, electronic wallets.<sup>4</sup>

13 **III. Patent Local Rule 3-3(d) Disclosure: Invalidity For Failure to Satisfy**  
14 **35 U.S.C. § 112.**

15 Each of the asserted InterTrust patent claims is invalid as indefinite, for inadequate  
16 written description and for lack of enablement as those requirement are set forth by 35 U.S.C. §  
17 112.<sup>5</sup> In accordance with Patent L.R. 3-3(d), Microsoft identifies in Appendix C, attached  
18 hereto, exemplary bases, on an element by element basis, for invalidating each asserted claim of  
19 each asserted patent for indefiniteness and lack of an adequate written description. The asserted  
20 claims are unclear in scope and not nearly as precise as the subject matter allows.

21 Appendix C contains examples of why the indefiniteness prohibited by 35 U.S.C.  
22 § 112(2) arises from many causes, including:

- 23 a) use of terms that lack an ordinary meaning in the art and are undefined in the  
24 specification;

25 \_\_\_\_\_  
26 <sup>4</sup> These examples are not intended to be an exhaustive list and are set forth for illustrative  
purposes.

27 <sup>5</sup> Microsoft also asserts that one or more of the claims are invalid under 35 U.S.C. § 112(1) for  
28 failure to identify the "best mode" for carrying out the invention. However, pursuant to Patent  
L.R. 3-3(d), Microsoft's arguments related to that defense are not required to be set forth in the  
attached charts, and hence are not included in Exhibit C.

- b) use of terms that are used in the specification in a manner which is internally inconsistent, as well as inconsistent with their ordinary meaning, but are not specifically defined in the specification;
- c) InterTrust's refusal to identify the structure in the application's written description linked to claim elements subject to 35 U.S.C. § 112, ¶6 ("means (or step) plus function);
- d) such excessive disclaimers of specificity of a term that the term becomes meaningless;
- e) inconsistent uses of a term within a single specification;
- f) inconsistent uses of a term between a specification and something allegedly incorporated into that specification;
- g) inconsistencies within the language of a given claim;
- h) inclusion of the same element twice in a claim, resulting in improper double inclusion of an element;
- i) impermissible reference to trademarks in a claim;
- j) inconsistent use of terms that may be synonyms for one another or that could be used to mean same thing or different things.

The indefiniteness of the asserted claims is exacerbated by InterTrust's attempt to apply these claims to the very different structures and techniques of (or those that InterTrust wrongly attributes to) the Microsoft accused products. Microsoft reserves the right to modify this listing, *e.g.*, if and when InterTrust clarifies its infringement contentions and claim construction positions.

Appendix C also provides examples of the lack of an adequate written description supporting the asserted claims. For example, the asserted claims fail for lack of an adequate written description under 35 U.S.C. § 112(1) to the extent that they are construed to contradict and/or fail to require the essential, non-optional alleged attributes of the alleged "inventions" identified in their specifications (and any specification allegedly incorporated by reference) and the applications from which the patents issued. The asserted claims also fail to comply with the



1 written description requirement as set forth in *Gentry Gallery, Inc v. Berkline Corp.*, 134 F.3d  
2 1473 (Fed. Cir 1998) to the extent that the scope of any of them exceeds the scope of the alleged  
3 "invention" as set forth in the accompanying specification (and any specification allegedly  
4 incorporated therein). For example, in the specification of U.S. Patent No. 6,253,193 InterTrust  
5 states that:

6 The present invention assertedly provides a new kind of "virtual  
7 distribution environment" (called "VDE" in this document) that  
8 secures, administers, and audits electronic information use. VDE  
9 also features fundamentally important capabilities for managing  
10 content that travels "across" the "information highway." These  
11 capabilities comprise a rights protection solution that serves all  
electronic community members. These members include content  
creators and distributors, financial service providers, end-users, and  
others. VDE is the first general purpose, configurable, transaction  
control/rights protection solution for users of computers, other  
electronic appliances, networks, and the information highway.

12 Accordingly any claims that rely on this specification must be limited in scope to the invention  
13 described therein. To the extent that they exceed the scope of what is described, they are invalid  
14 under the written description requirement.

15 Microsoft further contends that each asserted claim, when viewed in its entirety, is  
16 invalid under 35 U.S.C. § 112(1) because the specifications of the patents fail to teach one of  
17 ordinary skill in the art how to practice the entirety of the broad scope of those claims without  
18 undue experimentation.

19 For example, based on the specification, most if not all of the claims involve the  
20 use of software of one kind or another, yet the specification does not disclose any software  
21 programs that could be used or adapted for use in practicing the claimed inventions. In addition  
22 to failing to disclose any software program by explicit reference, the patent specifications does  
23 not describe with sufficient specificity the identity of software programs needed to practice the  
24 claimed invention that would prevent the need for undue experimentation by a person skilled in  
25 the art to practice the claimed inventions. The claims set forth a multiplicity of functions,  
26 features, and characteristics for the purported inventions, and the specifications are replete with  
27 references to software necessary to practicing the inventions, yet the specification neither  
28 identifies enabling software that satisfies such requirements, nor provides guidance that would

1 allow a person of ordinary skill in the art to program enabling software without undue  
2 experimentation.<sup>6</sup>

3 As shown in Appendix C<sup>7</sup>, asserted claims contain terms that are subject to,  
4 multiple definitions, and the patent specifications do not disclose one or more of the alternate  
5 definitions. The full scope of the claim is therefore not described or taught in the specification.  
6 Any claim in Appendix C that contains a claim term subject to multiple definitions fails to teach  
7 the full scope of the claim and therefore fails the enablement requirement if the specification does  
8 not specify the operative definition for the term.

9 There are numerous other reasons that the unprecedented breadth of scope of the  
10 claims asserted by InterTrust are not enabled, including InterTrust's failure to implement the  
11 claims after substantial investment of time, labor, and money. Given the complexity of the  
12 asserted patents and their interdisciplinary subject matter, the state of the prior art, the absence of  
13 predictability of the prior art, the amount of experimentation necessary to practice the patents, the  
14 absence of embodiments, and the absence of guidance for practicing the invention provided in the  
15 specification<sup>8</sup>, the relative skill of those practicing the art and the breadth of the claims, the  
16 asserted claims fail to meet the enablement requirement of 35 U.S.C. § 112 ¶ 1.

17 The full claims of the asserted patents fail to satisfy the enablement and written  
18 description requirements for the following reasons:

19 The '683 Patent

20 Claim 2: Claim 2 of the '683 patent fails the enablement requirement because the  
21 specification does not teach a person of ordinary skill in the relevant arts how to practice the  
22 purportedly disclosed invention without undue experimentation in the development of enabling  
23

24 <sup>6</sup> In its discovery responses, InterTrust refuses to identify software programs necessary for  
25 practicing the inventions purportedly disclosed in the asserted patents. *See* InterTrust responses to  
26 Microsoft Interrogatory Nos. 39 and 40.

27 <sup>7</sup> *See* Appendix C for further element by element analysis of invalidity for failure to satisfy 35  
28 U.S.C. § 112 ¶ 1. The indefiniteness of the claim terms addressed in Exhibit C affect enablement  
because the indefiniteness of the claim terms prevents the specification from adequately teaching  
a person of skill in the art how to make and use the full scope of the claimed inventions without  
undue experimentation.

<sup>8</sup> The failure of the specifications to provide necessary guidance also establishes that the claims  
fail to meet the written description requirement of 35 U.S.C. § 112 ¶ 1.

1 software and operation of such software on accompanying hardware. Specifically, limitations in  
2 Claim 2 (63:40-66), both explicitly and implicitly require software. Since no software is  
3 disclosed in the specification, and since the specification provides no useful programming  
4 guidance, a person of skill in the art would have to engage a process of trial and error, perhaps  
5 followed by bottom up software development, in order to make and use the full scope of Claim 2.  
6 Claim 2 also fails the enablement requirement in light of the breadth of the subject matter  
7 claimed (e.g. "security", "secure container," "containing"). The specification does not teach a  
8 person of ordinary skill in the art how to practice the full scope of the claim, and a person of skill  
9 in the art would therefore be required to undertake undue experimentation in order to make and  
10 use the invention across the full scope claimed. For these reasons and for the reasons stated  
11 above with respect to all of the claims, Claim 2 fails the enablement and written description  
12 requirements of 35 U.S.C. § 112 ¶ 1.

13           **Claim 3:** Claim 3 of the '683 patent fails the enablement requirement because the  
14 specification does not teach a person of ordinary skill in the relevant arts how to practice the  
15 purportedly disclosed invention without undue experimentation in the development of enabling  
16 software and operation of such software on accompanying hardware. Specifically, several  
17 limitations in Claim 3 (64:6-30), both explicitly and implicitly require software. Since no  
18 software is disclosed in the specification, and insufficient programming guidance (if any) is  
19 provided by the specification, a person of skill in the art would have to engage a process of trial  
20 and error, perhaps followed by bottom up software development, in order to make and use the full  
21 scope of Claim 3. Claim 3 also fails the enablement requirement in light of the breadth of the  
22 subject matter claimed (e.g. "security", "secure container," "rule"). The specification does not  
23 teach a person of ordinary skill in the art how to practice the full scope of the claim, and a person  
24 of skill in the art would therefore be required to undertake undue experimentation in order to  
25 make and use the invention across the full scope claimed. For these reasons and for the reasons  
26 stated above with respect to all of the claims, Claim 3 fails the enablement and written description  
27 requirements of 35 U.S.C. § 112 ¶ 1.

28           **Claim 4:** Claim 4 is dependent upon Claim 3 and thus fails the enablement and

1 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
2 the limitation of Claim 4 fails because it requires additional undisclosed software.

3           **Claim 5:** Claim 5 of the '683 patent fails the enablement requirement because the  
4 specification does not teach a person of ordinary skill in the relevant arts how to practice the  
5 purportedly disclosed invention without undue experimentation in the development of enabling  
6 software and operation of such software on accompanying hardware. Specifically, several  
7 limitations in Claim 5 (64:41-66), both explicitly and implicitly require software. Since no  
8 software is disclosed in the specification, and no meaningful programming guidance is provided,  
9 a person of skill in the art would have to engage a process of trial and error, perhaps followed by  
10 bottom up software development, in order to make and use the full scope of Claim 5. Claim 5  
11 also fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
12 "security", "secure container," "governed item"). The specification does not teach a person of  
13 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
14 would therefore be required to undertake undue experimentation in order to make and use the  
15 invention across the full scope claimed. For these reasons and for the reasons stated above with  
16 respect to all of the claims, Claim 5 fails the enablement and written description requirements of  
17 35 U.S.C. § 112 ¶ 1.

18           **Claim 6:** Claim 6 is dependent upon Claim 5 and thus fails the enablement and  
19 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
20 the limitation of Claim 6 fails because it requires additional undisclosed software..

21           **Claim 28:** Claim 28 of the '683 patent fails the enablement requirement because  
22 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
23 purportedly disclosed invention without undue experimentation in the development of enabling  
24 software and operation of such software on accompanying hardware. Specifically, several  
25 limitations in Claim 28 (70:20-59), both explicitly and implicitly require software. Since no  
26 software is disclosed in the specification, and no meaningful programming guidance is provided,  
27 a person of skill in the art would have to engage a process of trial and error, perhaps followed by  
28 bottom up software development, in order to make and use the full scope of Claim 28. Claim 28

1 also fails the enablement requirement in light of the breadth of the subject matter claimed (*e.g.*  
2 “security,” “electronic intermediary,” “being associated with . . .”). The specification does not  
3 teach a person of ordinary skill in the art how to practice the full scope of the claim, and a person  
4 of skill in the art would therefore be required to undertake undue experimentation in order to  
5 make and use the invention across the full scope claimed. For these reasons and for the reasons  
6 stated above with respect to all of the claims, Claim 28 fails the enablement and written  
7 description requirements of 35 U.S.C. § 112 ¶ 1.

8           **Claim 29:** Claim 29 is dependent upon Claim 28 and fails the enablement and  
9 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
10 the limitation of Claim 29 fails because it requires additional undisclosed software. Claim 29 also  
11 fails the enablement requirement in light of the breadth of the subject matter claimed (*e.g.*  
12 “operatively connected”). The specification does not teach a person of ordinary skill in the art  
13 how to practice the full scope of the claim, and a person of skill in the art would therefore be  
14 required to undertake undue experimentation in order to make and use the invention across the  
15 full scope claimed

16           **Claim 56:** Claim 56 of the ‘683 patent fails the enablement requirement because  
17 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
18 purportedly disclosed invention without undue experimentation in the development of enabling  
19 software and operation of such software on accompanying hardware. Specifically, several  
20 limitations in Claim 56 (77:34-56), both explicitly and implicitly require software. Since no  
21 software is disclosed in the specification, and no meaningful programming guidance is provided,  
22 a person of skill in the art would have to engage a process of trial and error, perhaps followed by  
23 bottom up software development, in order to make and use the full scope of Claim 56. Claim 56  
24 also fails the enablement requirement in light of the breadth of the subject matter claimed (*e.g.*  
25 “security,” “secure container,” “secure electronic container”). The specification does not teach a  
26 person of ordinary skill in the art how to practice the full scope of the claim, and a person of skill  
27 in the art would therefore be required to undertake undue experimentation in order to make and  
28 use the invention across the full scope claimed. For these reasons and for the reasons stated

1 above with respect to all of the claims, Claim 56 fails the enablement and written description  
2 requirements of 35 U.S.C. § 112 ¶ 1.

3           **Claim 126:** Claim 126 of the '683 patent fails the enablement requirement  
4 because the specification does not teach a person of ordinary skill in the relevant arts how to  
5 practice the purportedly disclosed invention without undue experimentation in the development of  
6 enabling software and operation of such software on accompanying hardware. Specifically,  
7 several limitations in Claim 126 (82:50-83:7), both explicitly and implicitly require software.  
8 Since no software is disclosed in the specification, and no meaningful programming guidance is  
9 provided, a person of skill in the art would have to engage a process of trial and error, perhaps  
10 followed by bottom up software development, in order to make and use the full scope of Claim  
11 126. Claim 126 also fails the enablement requirement in light of the breadth of the subject matter  
12 claimed (e.g. "security," "secure digital container," "trusted intermediary services"). The  
13 specification does not teach a person of ordinary skill in the art how to practice the full scope of  
14 the claim, and a person of skill in the art would therefore be required to undertake undue  
15 experimentation in order to make and use the invention across the full scope claimed. For these  
16 reasons and for the reasons stated above with respect to all of the claims, Claim 126 fails the  
17 enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

18           **Claim 127:** Claim 127 is dependent upon Claim 126 and thus fails the enablement  
19 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
20 addition, the limitation of Claim 127 fails because it requires additional undisclosed software.  
21 Claim 127 also fails the enablement requirement in light of the breadth of the subject matter  
22 claimed (e.g. "at least in part identifies"). The specification does not teach a person of ordinary  
23 skill in the art how to practice the full scope of the claim, and a person of skill in the art would  
24 therefore be required to undertake undue experimentation in order to make and use the invention  
25 across the full scope claimed

#### 26           **The '193 Patent**

27           **Claim 1:** Claim 1 of the '193 patent fails the enablement requirement because the  
28 specification does not teach a person of ordinary skill in the relevant arts how to practice the

1 purportedly disclosed invention without undue experimentation in the development of enabling  
2 software and operation of such software on accompanying hardware. Specifically, several  
3 limitations in Claim 1 (320:62-321:18), both explicitly and implicitly require software. Since no  
4 software is disclosed in the specification, and no meaningful programming guidance is provided,  
5 a person of skill in the art would have to engage a process of trial and error, perhaps followed by  
6 bottom up software development, in order to make and use the full scope of Claim 1. Claim 1  
7 also fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
8 "budget control," "secure database," "copy control"). The specification does not teach a person  
9 of ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the  
10 art would therefore be required to undertake undue experimentation in order to make and use the  
11 invention across the full scope claimed. For these reasons and for the reasons stated above with  
12 respect to all of the claims, Claim 1 fails the enablement and written description requirements of  
13 35 U.S.C. § 112 ¶ 1.

14 Claim 2: Claim 2 is dependent upon Claim 1 and thus fails the enablement and  
15 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
16 the limitation of Claim 2 fails because it requires additional undisclosed software. Claim 127 also  
17 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g. "a time  
18 substantially contemporaneous"). The specification does not teach a person of ordinary skill in  
19 the art how to practice the full scope of the claim, and a person of skill in the art would therefore  
20 be required to undertake undue experimentation in order to make and use the invention across the  
21 full scope claimed.

22 Claim 3: Claim 3 is dependent upon Claim 2 and thus fails the enablement and  
23 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
24 the limitation of Claim 3 fails because it requires additional undisclosed software. Claim 3 also  
25 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
26 "encumbrance on said budget"). The specification does not teach a person of ordinary skill in the  
27 art how to practice the full scope of the claim, and a person of skill in the art would therefore be  
28 required to undertake undue experimentation in order to make and use the invention across the

1 full scope claimed.

2 Claim 4: Claim 4 is dependent upon Claim 3 and thus fails the enablement and  
3 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
4 the limitation of Claim 4 fails because it requires additional undisclosed software. Claim 4 also  
5 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g. "digital  
6 file authorized by said budget"). The specification does not teach a person of ordinary skill in the  
7 art how to practice the full scope of the claim, and a person of skill in the art would therefore be  
8 required to undertake undue experimentation in order to make and use the invention across the  
9 full scope claimed.

10 Claim 11: Claim 11 of the '193 patent fails the enablement requirement because  
11 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
12 purportedly disclosed invention without undue experimentation in the development of enabling  
13 software and operation of such software on accompanying hardware. Specifically, several  
14 limitations in Claim 11 (322:22-45), both explicitly and implicitly require software. Since no  
15 software is disclosed in the specification, and no meaningful programming guidance is provided,  
16 a person of skill in the art would have to engage a process of trial and error, perhaps followed by  
17 bottom up software development, in order to make and use the full scope of Claim 11. Claim 11  
18 also fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
19 "security," "secure memory," "features"). The specification does not teach a person of ordinary  
20 skill in the art how to practice the full scope of the claim, and a person of skill in the art would  
21 therefore be required to undertake undue experimentation in order to make and use the invention  
22 across the full scope claimed. For these reasons and for the reasons stated above with respect to  
23 all of the claims, Claim 11 fails the enablement and written description requirements of 35 U.S.C.  
24 § 112 ¶ 1.

25 Claim 15: Claim 15 of the '193 patent fails the enablement requirement because  
26 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
27 purportedly disclosed invention without undue experimentation in the development of enabling  
28 software and operation of such software on accompanying hardware. Specifically, several



1 limitations in Claim 15 (323:15-41), both explicitly and implicitly require software. Since no  
2 software is disclosed in the specification, and no meaningful programming guidance is provided,  
3 a person of skill in the art would have to engage a process of trial and error, perhaps followed by  
4 bottom up software development, in order to make and use the full scope of Claim 15. Claim 15  
5 also fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
6 "security," "secure database"). The specification does not teach a person of ordinary skill in the  
7 art how to practice the full scope of the claim, and a person of skill in the art would therefore be  
8 required to undertake undue experimentation in order to make and use the invention across the  
9 full scope claimed. For these reasons and for the reasons stated above with respect to all of the  
10 claims, Claim 15 fails the enablement and written description requirements of 35 U.S.C. § 112  
11 ¶ 1.

12           **Claim 16:** Claim 16 is dependent upon Claim 15 and thus fails the enablement  
13 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
14 addition, the limitation of Claim 16 fails because it requires additional undisclosed software.  
15 Claim 16 also fails the enablement requirement in light of the breadth of the subject matter  
16 claimed (e.g. "authentication step"). The specification does not teach a person of ordinary skill in  
17 the art how to practice the full scope of the claim, and a person of skill in the art would therefore  
18 be required to undertake undue experimentation in order to make and use the invention across the  
19 full scope claimed

20           **Claim 19:** Claim 19 of the '193 patent fails the enablement requirement because  
21 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
22 purportedly disclosed invention without undue experimentation in the development of enabling  
23 software and operation of such software on accompanying hardware. Specifically, several  
24 limitations in Claim 19 (324:9-37), both explicitly and implicitly require software. Since no  
25 software is disclosed in the specification, and no meaningful programming guidance is provided,  
26 a person of skill in the art would have to engage a process of trial and error, perhaps followed by  
27 bottom up software development, in order to make and use the full scope of Claim 19. Claim 19  
28 also fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.

1 "clearinghouse"). The specification does not teach a person of ordinary skill in the art how to  
2 practice the full scope of the claim, and a person of skill in the art would therefore be required to  
3 undertake undue experimentation in order to make and use the invention across the full scope  
4 claimed. For these reasons and for the reasons stated above with respect to all of the claims,  
5 Claim 19 fails the enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

6 Claim 51: Claim 51 of the '193 patent fails the enablement requirement because  
7 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
8 purportedly disclosed invention without undue experimentation in the development of enabling  
9 software and operation of such software on accompanying hardware. Specifically, several  
10 limitations in Claim 51 (326:51-327:12), both explicitly and implicitly require software. Since no  
11 software is disclosed in the specification, and no meaningful programming guidance is provided,  
12 a person of skill in the art would have to engage a process of trial and error, perhaps followed by  
13 bottom up software development, in order to make and use the full scope of Claim 51. Claim 51  
14 also fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
15 "security," "clearinghouse," "location remote from"). The specification does not teach a person  
16 of ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the  
17 art would therefore be required to undertake undue experimentation in order to make and use the  
18 invention across the full scope claimed. For these reasons and for the reasons stated above with  
19 respect to all of the claims, Claim 51 fails the enablement and written description requirements of  
20 35 U.S.C. § 112 ¶ 1.

#### 21 The '861 Patent

22 Claim 34: Claim 34 of the '861 patent fails the enablement requirement because  
23 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
24 purportedly disclosed invention without undue experimentation in the development of enabling  
25 software. Specifically, several limitations in Claim 34 (24:65-25:15), both explicitly and  
26 implicitly require software. Since no software is disclosed in the specification, and no  
27 meaningful programming guidance is provided, a person of skill in the art would have to engage a  
28 process of trial and error, perhaps followed by bottom up software development, in order to make

1 and use the full scope of Claim 34. Claim 34 also fails the enablement requirement in light of the  
2 breadth of the subject matter claimed (e.g. "descriptive data structure," "element information,"  
3 "metadata rules"). The specification does not teach a person of ordinary skill in the art how to  
4 practice the full scope of the claim, and a person of skill in the art would therefore be required to  
5 undertake undue experimentation in order to make and use the invention across the full scope  
6 claimed. For these reasons and for the reasons stated above with respect to all of the claims,  
7 Claim 34 fails the enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

8 Claim 35: Claim 35 is dependent on Claim 34 and thus fails the enablement and  
9 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
10 the limitation of Claim 35 fails because it requires additional undisclosed software. Claim 35 also  
11 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g. "rights  
12 management data structure"). The specification does not teach a person of ordinary skill in the art  
13 how to practice the full scope of the claim, and a person of skill in the art would therefore be  
14 required to undertake undue experimentation in order to make and use the invention across the  
15 full scope claimed.

16 Claim 36: Claim 36 is dependent on Claim 35 and thus fails the enablement and  
17 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
18 the limitation of Claim 36 fails because it requires additional undisclosed software. Claim 36 also  
19 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
20 "content," "rules at least in part governing . . ."). The specification does not teach a person of  
21 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
22 would therefore be required to undertake undue experimentation in order to make and use the  
23 invention across the full scope claimed.

24 Claim 37: Claim 37 is dependent on Claim 36 and thus fails the enablement and  
25 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
26 the limitation of Claim 37 fails because it requires additional undisclosed software. Claim 37 also  
27 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
28 "descriptive data structure is stored within said first secure container"). The specification does

1 not teach a person of ordinary skill in the art how to practice the full scope of the claim, and a  
2 person of skill in the art would therefore be required to undertake undue experimentation in order  
3 to make and use the invention across the full scope claimed.

4 Claim 44: Claim 44 is dependent on Claim 34 and thus fails the enablement and  
5 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
6 the limitation of Claim 44 fails because it requires additional undisclosed software. Claim 44 also  
7 fails the enablement requirement in light of the breadth of the subject matter claimed (*e.g.*  
8 “representation of the format of data . . .”). The specification does not teach a person of ordinary  
9 skill in the art how to practice the full scope of the claim, and a person of skill in the art would  
10 therefore be required to undertake undue experimentation in order to make and use the invention  
11 across the full scope claimed.

12 Claim 45: Claim 45 is dependent on Claim 44 and thus fails the enablement and  
13 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
14 the limitation of Claim 45 fails because it requires additional undisclosed software. Claim 45 also  
15 fails the enablement requirement in light of the breadth of the subject matter claimed (*e.g.*  
16 “information regarding elements . . .”). The specification does not teach a person of ordinary skill  
17 in the art how to practice the full scope of the claim, and a person of skill in the art would  
18 therefore be required to undertake undue experimentation in order to make and use the invention  
19 across the full scope claimed.

20 Claim 46: Claim 46 is dependent on Claim 44 and thus fails the enablement and  
21 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
22 the limitation of Claim 46 fails because it requires additional undisclosed software. Claim 46 also  
23 fails the enablement requirement in light of the breadth of the subject matter claimed (*e.g.* “target  
24 data block”). The specification does not teach a person of ordinary skill in the art how to practice  
25 the full scope of the claim, and a person of skill in the art would therefore be required to  
26 undertake undue experimentation in order to make and use the invention across the full scope  
27 claimed.

28 Claim 47: Claim 47 is dependent on Claim 46 and thus fails the enablement and

1 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
2 the limitation of Claim 47 fails because it requires additional undisclosed software. Claim 47 also  
3 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g. "target  
4 data block," "target environment"). The specification does not teach a person of ordinary skill in  
5 the art how to practice the full scope of the claim, and a person of skill in the art would therefore  
6 be required to undertake undue experimentation in order to make and use the invention across the  
7 full scope claimed.

8           **Claim 48:** Claim 48 is dependent on Claim 46 and thus fails the enablement and  
9 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
10 the limitation of Claim 48 fails because it requires additional undisclosed software. Claim 48 also  
11 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
12 "source," "source message field"). The specification does not teach a person of ordinary skill in  
13 the art how to practice the full scope of the claim, and a person of skill in the art would therefore  
14 be required to undertake undue experimentation in order to make and use the invention across the  
15 full scope claimed.

16           **Claim 58:** Claim 34 of the '861 patent fails the enablement requirement because  
17 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
18 purportedly disclosed invention without undue experimentation in the development of enabling  
19 software. Specifically, several limitations in Claim 34 (24:65-25:15), both explicitly and  
20 implicitly require software. Since no software is disclosed in the specification, and no  
21 meaningful programming guidance is provided, a person of skill in the art would have to engage a  
22 process of trial and error, perhaps followed by bottom up software development, in order to make  
23 and use the full scope of Claim 34. Claim 34 also fails the enablement requirement in light of the  
24 breadth of the subject matter claimed (e.g. "metadata information," "generating or identifying at  
25 least one rule . . ."). The specification does not teach a person of ordinary skill in the art how to  
26 practice the full scope of the claim, and a person of skill in the art would therefore be required to  
27 undertake undue experimentation in order to make and use the invention across the full scope  
28 claimed. For these reasons and for the reasons stated above with respect to all of the claims,

1 Claim 34 fails the enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

2 Claim 64: Claim 64 is dependent on Claim 58 and thus fails the enablement and  
3 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
4 the limitation of Claim 64 fails because it requires additional undisclosed software. Claim 64 also  
5 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
6 "creation of said first secure container"). The specification does not teach a person of ordinary  
7 skill in the art how to practice the full scope of the claim, and a person of skill in the art would  
8 therefore be required to undertake undue experimentation in order to make and use the invention  
9 across the full scope claimed.

10 Claim 67: Claim 67 is dependent on Claim 64 and thus fails the enablement and  
11 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
12 the limitation of Claim 67 fails because it requires additional undisclosed software. Claim 67 also  
13 fails the enablement requirement in light of the breadth of the subject matter claimed. The  
14 specification does not teach a person of ordinary skill in the art how to practice the full scope of  
15 the claim, and a person of skill in the art would therefore be required to undertake undue  
16 experimentation in order to make and use the invention across the full scope claimed.

17 Claim 68: Claim 68 is dependent on Claim 67 and thus fails the enablement and  
18 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
19 the limitation of Claim 68 fails because it requires additional undisclosed software. Claim 68 also  
20 fails the enablement requirement in light of the breadth of the subject matter claimed. The  
21 specification does not teach a person of ordinary skill in the art how to practice the full scope of  
22 the claim, and a person of skill in the art would therefore be required to undertake undue  
23 experimentation in order to make and use the invention across the full scope claimed.

24 Claim 71: Claim 71 is dependent on Claim 58 and thus fails the enablement and  
25 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
26 the limitation of Claim 71 fails because it requires additional undisclosed software. Claim 71 also  
27 fails the enablement requirement in light of the breadth of the subject matter claimed. The  
28 specification does not teach a person of ordinary skill in the art how to practice the full scope of

1 the claim, and a person of skill in the art would therefore be required to undertake undue  
2 experimentation in order to make and use the invention across the full scope claimed.

3 Claim 72: Claim 72 depends to Claim 58 and fails the enablement and written  
4 description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition, the  
5 limitation of Claim 72 fails because it requires additional undisclosed software.

### 6 The '891 Patent

7 Claim 1: Claim 1 of the '891 patent fails the enablement requirement because the  
8 specification does not teach a person of ordinary skill in the relevant arts how to practice the  
9 purportedly disclosed invention without undue experimentation in the development of enabling  
10 software. Specifically, several limitations in Claim 1 (318:59-319:8), both explicitly and  
11 implicitly require software. Since no software is disclosed in the specification, and no  
12 meaningful programming guidance is provided, a person of skill in the art would have to engage a  
13 process of trial and error, perhaps followed by bottom up software development, in order to make  
14 and use the full scope of Claim 1. Claim 1 also fails the enablement requirement in light of the  
15 breadth of the subject matter claimed (e.g. "securely receiving," "secure operating environment,"  
16 "control"). The specification does not teach a person of ordinary skill in the art how to practice  
17 the full scope of the claim, and a person of skill in the art would therefore be required to  
18 undertake undue experimentation in order to make and use the invention across the full scope  
19 claimed. For these reasons and for the reasons stated above with respect to all of the claims,  
20 Claim 1 fails the enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

21 Claim 22: Claim 22 of the '891 patent fails the enablement requirement because  
22 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
23 purportedly disclosed invention without undue experimentation in the development of enabling  
24 software. Specifically, several limitations in Claim 22 (320:15-31) both explicitly and implicitly  
25 require software. Since no software is disclosed in the specification, and no meaningful  
26 programming guidance is provided, a person of skill in the art would have to engage a process of  
27 trial and error, perhaps followed by bottom up software development, in order to make and use  
28 the full scope of Claim 22. Claim 22 also fails the enablement requirement in light of the breadth

1 of the subject matter claimed (e.g. "securely combining," "control arrangement," "securely  
2 requiring"). The specification does not teach a person of ordinary skill in the art how to practice  
3 the full scope of the claim, and a person of skill in the art would therefore be required to  
4 undertake undue experimentation in order to make and use the invention across the full scope  
5 claimed. For these reasons and for the reasons stated above with respect to all of the claims,  
6 Claim 22 fails the enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

7           **Claim 23:** Claim 23 is dependent on Claim 34 and thus fails the enablement and  
8 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
9 the limitation of Claim 23 fails because it requires additional undisclosed software.

10           **Claim 26:** Claim 26 of the '891 patent fails the enablement requirement because  
11 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
12 purportedly disclosed invention without undue experimentation in the development of enabling  
13 software. Specifically, several limitations in Claim 26 (320:40-55) both explicitly and implicitly  
14 require software. Since no software is disclosed in the specification, and no meaningful  
15 programming guidance is provided, a person of skill in the art would have to engage a process of  
16 trial and error, perhaps followed by bottom up software development, in order to make and use  
17 the full scope of Claim 26. Claim 26 also fails the enablement requirement in light of the breadth  
18 of the subject matter claimed (e.g. "composite data item," "securely providing,"). The  
19 specification does not teach a person of ordinary skill in the art how to practice the full scope of  
20 the claim, and a person of skill in the art would therefore be required to undertake undue  
21 experimentation in order to make and use the invention across the full scope claimed. For these  
22 reasons and for the reasons stated above with respect to all of the claims, Claim 26 fails the  
23 enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

24           **Claim 27:** Claim 27 is dependent on Claim 26 and thus fails the enablement and  
25 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
26 the limitation of Claim 27 fails because it requires additional undisclosed software. Claim 27 also  
27 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
28 "combining step"). The specification does not teach a person of ordinary skill in the art how to



1 practice the full scope of the claim, and a person of skill in the art would therefore be required to  
2 undertake undue experimentation in order to make and use the invention across the full scope  
3 claimed.

4 Claim 28: Claim 28 is dependent on Claim 26 and thus fails the enablement and  
5 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
6 the limitation of Claim 28 fails because it requires additional undisclosed software. Claim 28 also  
7 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
8 "composite"). The specification does not teach a person of ordinary skill in the art how to  
9 practice the full scope of the claim, and a person of skill in the art would therefore be required to  
10 undertake undue experimentation in order to make and use the invention across the full scope  
11 claimed.

12 Claim 29: Claim 29 is dependent on Claim 26 and thus fails the enablement and  
13 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
14 the limitation of Claim 29 fails because it requires additional undisclosed software. Claim 29 also  
15 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
16 "ensuring the integrity of said association . . ."). The specification does not teach a person of  
17 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
18 would therefore be required to undertake undue experimentation in order to make and use the  
19 invention across the full scope claimed.

20 Claim 31: Claim 31 is dependent on Claim 26 and thus fails the enablement and  
21 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
22 the limitation of Claim 31 fails because it requires additional undisclosed software. Claim 31 also  
23 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
24 "codelivering"). The specification does not teach a person of ordinary skill in the art how to  
25 practice the full scope of the claim, and a person of skill in the art would therefore be required to  
26 undertake undue experimentation in order to make and use the invention across the full scope  
27 claimed.

28 Claim 35: Claim 35 of the '891 patent fails the enablement requirement because

1 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
2 purportedly disclosed invention without undue experimentation in the development of enabling  
3 software. Specifically, several limitations in Claim 35 (321:29-41), both explicitly and implicitly  
4 require software. Since no software is disclosed in the specification, and no meaningful  
5 programming guidance is provided, a person of skill in the art would have to engage a process of  
6 trial and error, perhaps followed by bottom up software development, in order to make and use  
7 the full scope of Claim 35. Claim 35 also fails the enablement requirement in light of the breadth  
8 of the subject matter claimed (e.g. "secure operating environment"). The specification does not  
9 teach a person of ordinary skill in the art how to practice the full scope of the claim, and a person  
10 of skill in the art would therefore be required to undertake undue experimentation in order to  
11 make and use the invention across the full scope claimed. For these reasons and for the reasons  
12 stated above with respect to all of the claims, Claim 35 fails the enablement and written  
13 description requirements of 35 U.S.C. § 112 ¶ 1.

14           **Claim 36:** Claim 36 of the '891 patent fails the enablement requirement because  
15 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
16 purportedly disclosed invention without undue experimentation in the development of enabling  
17 software. Specifically, several limitations in Claim 36 (321:44-57), both explicitly and implicitly  
18 require software. Since no software is disclosed in the specification, and no meaningful  
19 programming guidance is provided, a person of skill in the art would have to engage a process of  
20 trial and error, perhaps followed by bottom up software development, in order to make and use  
21 the full scope of Claim 36. Claim 36 also fails the enablement requirement in light of the breadth  
22 of the subject matter claimed (e.g. "secure operating environment system," "operatively  
23 connected," "logically associated with"). The specification does not teach a person of ordinary  
24 skill in the art how to practice the full scope of the claim, and a person of skill in the art would  
25 therefore be required to undertake undue experimentation in order to make and use the invention  
26 across the full scope claimed. For these reasons and for the reasons stated above with respect to  
27 all of the claims, Claim 36 fails the enablement and written description requirements of 35 U.S.C.  
28 § 112 ¶ 1.

1           **Claim 39:** Claim 39 is dependent on Claim 22 and thus fails the enablement and  
2 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
3 the limitation of Claim 39 fails because it requires additional undisclosed software. Claim 39 also  
4 fails the enablement requirement in light of the breadth of the subject matter claimed (*e.g.*  
5 “persistently associating,” “control arrangement”). The specification does not teach a person of  
6 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
7 would therefore be required to undertake undue experimentation in order to make and use the  
8 invention across the full scope claimed.

9           **Claim 40:** Claim 40 is dependent upon Claim 26 and thus fails the enablement  
10 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
11 addition, the limitation of Claim 40 fails because it requires additional undisclosed software.  
12 Claim 40 also fails the enablement requirement in light of the breadth of the subject matter  
13 claimed (*e.g.* “control arrangement”). The specification does not teach a person of ordinary skill  
14 in the art how to practice the full scope of the claim, and a person of skill in the art would  
15 therefore be required to undertake undue experimentation in order to make and use the invention  
16 across the full scope claimed.

17           **Claim 51:** Claim 51 is dependent upon Claim 1 and thus fails the enablement and  
18 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
19 the limitation of Claim 51 fails because it requires additional undisclosed software. Claim 51 also  
20 fails the enablement requirement in light of the breadth of the subject matter claimed (*e.g.* “end  
21 user electronic appliance,” “secure processing step”). The specification does not teach a person  
22 of ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the  
23 art would therefore be required to undertake undue experimentation in order to make and use the  
24 invention across the full scope claimed.

25           **Claim 53:** Claim 53 is dependent upon Claim 22 and thus fails the enablement  
26 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
27 addition, the limitation of Claim 53 fails because it requires additional undisclosed software.  
28 Claim 53 also fails the enablement requirement in light of the breadth of the subject matter

1 claimed (e.g. "end user electronic appliance"). The specification does not teach a person of  
2 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
3 would therefore be required to undertake undue experimentation in order to make and use the  
4 invention across the full scope claimed.

5           Claim 54: Claim 54 is dependent upon Claim 26 and thus fails the enablement  
6 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
7 addition, the limitation of Claim 54 fails because it requires additional undisclosed software.  
8 Claim 54 also fails the enablement requirement in light of the breadth of the subject matter  
9 claimed (e.g. "end user electronic appliance"). The specification does not teach a person of  
10 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
11 would therefore be required to undertake undue experimentation in order to make and use the  
12 invention across the full scope claimed.

13           Claim 56: Claim 56 is dependent upon Claim 35 and thus fails the enablement  
14 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
15 addition, the limitation of Claim 56 fails because it requires additional undisclosed software.  
16 Claim 56 also fails the enablement requirement in light of the breadth of the subject matter  
17 claimed (e.g. "end user electronic appliance"). The specification does not teach a person of  
18 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
19 would therefore be required to undertake undue experimentation in order to make and use the  
20 invention across the full scope claimed.

21           Claim 57: Claim 57 is dependent upon Claim 36 and thus fails the enablement  
22 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
23 addition, the limitation of Claim 57 fails because it requires additional undisclosed software.  
24 Claim 57 also fails the enablement requirement in light of the breadth of the subject matter  
25 claimed (e.g. "end user electronic appliance," "protected processing environment"). The  
26 specification does not teach a person of ordinary skill in the art how to practice the full scope of  
27 the claim, and a person of skill in the art would therefore be required to undertake undue  
28 experimentation in order to make and use the invention across the full scope claimed.

1           **Claim 58:** Claim 58 is dependent upon Claim 1 and thus fails the enablement and  
2 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
3 the limitation of Claim 58 fails because it requires additional undisclosed software. Claim 58 also  
4 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
5 "entity's control"). The specification does not teach a person of ordinary skill in the art how to  
6 practice the full scope of the claim, and a person of skill in the art would therefore be required to  
7 undertake undue experimentation in order to make and use the invention across the full scope  
8 claimed.

9           **Claim 60:** Claim 60 is dependent upon Claim 22 and thus fails the enablement  
10 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
11 addition, the limitation of Claim 60 fails because it requires additional undisclosed software.  
12 Claim 60 also fails the enablement requirement in light of the breadth of the subject matter  
13 claimed (e.g. "supplying," "control"). The specification does not teach a person of ordinary skill  
14 in the art how to practice the full scope of the claim, and a person of skill in the art would  
15 therefore be required to undertake undue experimentation in order to make and use the invention  
16 across the full scope claimed.

17           **Claim 61:** Claim 61 is dependent upon Claim 26 and thus fails the enablement  
18 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
19 addition, the limitation of Claim 61 fails because it requires additional undisclosed software.  
20 Claim 61 also fails the enablement requirement in light of the breadth of the subject matter  
21 claimed (e.g. "providing"). The specification does not teach a person of ordinary skill in the art  
22 how to practice the full scope of the claim, and a person of skill in the art would therefore be  
23 required to undertake undue experimentation in order to make and use the invention across the  
24 full scope claimed.

25           **Claim 63:** Claim 63 is dependent upon Claim 35 and thus fails the enablement  
26 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
27 addition, the limitation of Claim 63 fails because it requires additional undisclosed software.  
28 Claim 63 also fails the enablement requirement in light of the breadth of the subject matter

1 claimed (e.g. "securely receiving"). The specification does not teach a person of ordinary skill in  
2 the art how to practice the full scope of the claim, and a person of skill in the art would therefore  
3 be required to undertake undue experimentation in order to make and use the invention across the  
4 full scope claimed.

5           **Claim 64:** Claim 64 is dependent upon Claim 36 and thus fails the enablement  
6 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
7 addition, the limitation of Claim 64 fails because it requires additional undisclosed software.  
8 Claim 64 also fails the enablement requirement in light of the breadth of the subject matter  
9 claimed (e.g. "controls"). The specification does not teach a person of ordinary skill in the art  
10 how to practice the full scope of the claim, and a person of skill in the art would therefore be  
11 required to undertake undue experimentation in order to make and use the invention across the  
12 full scope claimed.

13           **Claim 65:** Claim 65 is dependent upon Claim 1 and thus fails the enablement and  
14 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
15 the limitation of Claim 65 fails because it requires additional undisclosed software. Claim 65 also  
16 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g. "secure  
17 processing environment"). The specification does not teach a person of ordinary skill in the art  
18 how to practice the full scope of the claim, and a person of skill in the art would therefore be  
19 required to undertake undue experimentation in order to make and use the invention across the  
20 full scope claimed.

21           **Claim 67:** Claim 67 is dependent upon Claim 22 and thus fails the enablement  
22 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
23 addition, the limitation of Claim 67 fails because it requires additional undisclosed software.  
24 Claim 67 also fails the enablement requirement in light of the breadth of the subject matter  
25 claimed (e.g. "secure processing environment"). The specification does not teach a person of  
26 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
27 would therefore be required to undertake undue experimentation in order to make and use the  
28 invention across the full scope claimed.

1           **Claim 68:** Claim 68 is dependent upon Claim 26 and thus fails the enablement  
2 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
3 addition, the limitation of Claim 68 fails because it requires additional undisclosed software.  
4 Claim 68 also fails the enablement requirement in light of the breadth of the subject matter  
5 claimed (e.g. "secure processing environment"). The specification does not teach a person of  
6 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
7 would therefore be required to undertake undue experimentation in order to make and use the  
8 invention across the full scope claimed.

9           **Claim 70:** Claim 70 is dependent upon Claim 35 and thus fails the enablement  
10 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
11 addition, the limitation of Claim 70 fails because it requires additional undisclosed software.  
12 Claim 70 also fails the enablement requirement in light of the breadth of the subject matter  
13 claimed (e.g. "secure processing environment," "securely processing," "securely executing").  
14 The specification does not teach a person of ordinary skill in the art how to practice the full scope  
15 of the claim, and a person of skill in the art would therefore be required to undertake undue  
16 experimentation in order to make and use the invention across the full scope claimed.

17           **Claim 71:** Claim 71 is dependent upon Claim 1 and thus fails the enablement and  
18 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
19 the limitation of Claim 71 fails because it requires additional undisclosed software. Claim 71 also  
20 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
21 "securely combining," "control arrangement"). The specification does not teach a person of  
22 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
23 would therefore be required to undertake undue experimentation in order to make and use the  
24 invention across the full scope claimed.

25           **Claim 74:** Claim 74 is dependent upon Claim 35 and thus fails the enablement  
26 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
27 addition, the limitation of Claim 74 fails because it requires additional undisclosed software.  
28 Claim 74 also fails the enablement requirement in light of the breadth of the subject matter

1 claimed (e.g. "securely combining," "combined executable"). The specification does not teach a  
2 person of ordinary skill in the art how to practice the full scope of the claim, and a person of skill  
3 in the art would therefore be required to undertake undue experimentation in order to make and  
4 use the invention across the full scope claimed.

5           **Claim 75:** Claim 75 is dependent upon Claim 36 and thus fails the enablement  
6 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
7 addition, the limitation of Claim 75 fails because it requires additional undisclosed software.  
8 Claim 75 also fails the enablement requirement in light of the breadth of the subject matter  
9 claimed (e.g. "combined control arrangement"). The specification does not teach a person of  
10 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
11 would therefore be required to undertake undue experimentation in order to make and use the  
12 invention across the full scope claimed.

13           **Claim 76:** Claim 76 is dependent upon Claim 1 and thus fails the enablement and  
14 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
15 the limitation of Claim 76 fails because it requires additional undisclosed software. Claim 76 also  
16 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
17 "securely receiving steps," "independently performed at different times"). The specification does  
18 not teach a person of ordinary skill in the art how to practice the full scope of the claim, and a  
19 person of skill in the art would therefore be required to undertake undue experimentation in order  
20 to make and use the invention across the full scope claimed.

21           **Claim 79:** Claim 79 is dependent upon Claim 26 and thus fails the enablement  
22 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
23 addition, the limitation of Claim 79 fails because it requires additional undisclosed software.

24           **Claim 81:** Claim 81 is dependent upon Claim 35 and thus fails the enablement  
25 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
26 addition, the limitation of Claim 81 fails because it requires additional undisclosed software.  
27 Claim 81 also fails the enablement requirement in light of the breadth of the subject matter  
28 claimed (e.g. "securely receiving steps"). The specification does not teach a person of ordinary



1 skill in the art how to practice the full scope of the claim, and a person of skill in the art would  
2 therefore be required to undertake undue experimentation in order to make and use the invention  
3 across the full scope claimed.

4 Claim 82: Claim 82 is dependent upon Claim 36 and thus fails the enablement  
5 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
6 addition, the limitation of Claim 82 fails because it requires additional undisclosed software.  
7 Claim 82 also fails the enablement requirement in light of the breadth of the subject matter  
8 claimed (e.g. "controls"). The specification does not teach a person of ordinary skill in the art  
9 how to practice the full scope of the claim, and a person of skill in the art would therefore be  
10 required to undertake undue experimentation in order to make and use the invention across the  
11 full scope claimed.

12 Claim 84: Claim 84 is dependent upon Claim 1 and thus fails the enablement and  
13 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
14 the limitation of Claim 84 fails because it requires additional undisclosed software. Claim 84 also  
15 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
16 "first/second entity's control"). The specification does not teach a person of ordinary skill in the  
17 art how to practice the full scope of the claim, and a person of skill in the art would therefore be  
18 required to undertake undue experimentation in order to make and use the invention across the  
19 full scope claimed.

20 Claim 86: Claim 86 is dependent upon Claim 26 and thus fails the enablement  
21 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
22 addition, the limitation of Claim 86 fails because it requires additional undisclosed software.  
23 Claim 86 also fails the enablement requirement in light of the breadth of the subject matter  
24 claimed (e.g. "control"). The specification does not teach a person of ordinary skill in the art how  
25 to practice the full scope of the claim, and a person of skill in the art would therefore be required  
26 to undertake undue experimentation in order to make and use the invention across the full scope  
27 claimed.

28 Claim 88: Claim 88 is dependent upon Claim 36 and thus fails the enablement

1 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
2 addition, the limitation of Claim 88 fails because it requires additional undisclosed software.  
3 Claim 88 also fails the enablement requirement in light of the breadth of the subject matter  
4 claimed (e.g. "control"). The specification does not teach a person of ordinary skill in the art how  
5 to practice the full scope of the claim, and a person of skill in the art would therefore be required  
6 to undertake undue experimentation in order to make and use the invention across the full scope  
7 claimed.

8           **Claim 89:** Claim 89 is dependent upon Claim 1 and thus fails the enablement and  
9 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
10 the limitation of Claim 89 fails because it requires additional undisclosed software. Claim 89 also  
11 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.  
12 "control," "protected processing environment"). The specification does not teach a person of  
13 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
14 would therefore be required to undertake undue experimentation in order to make and use the  
15 invention across the full scope claimed.

16           **Claim 91:** Claim 91 is dependent upon Claim 22 and thus fails the enablement  
17 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
18 addition, the limitation of Claim 91 fails because it requires additional undisclosed software.  
19 Claim 91 also fails the enablement requirement in light of the breadth of the subject matter  
20 claimed. The specification does not teach a person of ordinary skill in the art how to practice the  
21 full scope of the claim, and a person of skill in the art would therefore be required to undertake  
22 undue experimentation in order to make and use the invention across the full scope claimed.

23           **Claim 94:** Claim 94 is dependent upon Claim 35 and thus fails the enablement  
24 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
25 addition, the limitation of Claim 94 fails because it requires additional undisclosed software.  
26 Claim 94 also fails the enablement requirement in light of the breadth of the subject matter  
27 claimed. The specification does not teach a person of ordinary skill in the art how to practice the  
28 full scope of the claim, and a person of skill in the art would therefore be required to undertake

1 undue experimentation in order to make and use the invention across the full scope claimed.

2           **Claim 95:** Claim 95 is dependent upon Claim 36 and thus fails the enablement  
3 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
4 addition, the limitation of Claim 95 fails because it requires additional undisclosed software.  
5 Claim 95 also fails the enablement requirement in light of the breadth of the subject matter  
6 claimed. The specification does not teach a person of ordinary skill in the art how to practice the  
7 full scope of the claim, and a person of skill in the art would therefore be required to undertake  
8 undue experimentation in order to make and use the invention across the full scope claimed.

9           **The '912 Patent**

10           **Claim 6:** Claim 6 of the '912 patent fails the enablement requirement because the  
11 specification does not teach a person of ordinary skill in the relevant arts how to practice the  
12 purportedly disclosed invention without undue experimentation in the development of enabling  
13 software. Specifically, several limitations in Claim 6 (326:65-327:23), both explicitly and  
14 implicitly require software. Since no software is disclosed in the specification, and no  
15 meaningful programming guidance is provided, a person of skill in the art would have to engage a  
16 process of trial and error, perhaps followed by bottom up software development, in order to make  
17 and use the full scope of Claim 6. Claim 6 also fails the enablement requirement in light of the  
18 breadth of the subject matter claimed (e.g. "relatively lower level of security," "private portion  
19 characterized by . . . ," "accessing," "record"). The specification does not teach a person of  
20 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
21 would therefore be required to undertake undue experimentation in order to make and use the  
22 invention across the full scope claimed. For these reasons and for the reasons stated above with  
23 respect to all of the claims, Claim 6 fails the enablement and written description requirements of  
24 35 U.S.C. § 112 ¶ 1.

25           **Claim 7:** Claim 7 is dependent upon Claim 8 and thus fails the enablement and  
26 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
27 the limitation of Claim 7 fails because it requires additional undisclosed software. Claim 7 also  
28 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.

1 "relatively higher/lower level of security"). The specification does not teach a person of ordinary  
2 skill in the art how to practice the full scope of the claim, and a person of skill in the art would  
3 therefore be required to undertake undue experimentation in order to make and use the invention  
4 across the full scope claimed.

5 Claim 8: Claim 8 of the '912 patent fails the enablement requirement because the  
6 specification does not teach a person of ordinary skill in the relevant arts how to practice the  
7 purportedly disclosed invention without undue experimentation in the development of enabling  
8 software. Specifically, several limitations in Claim 8 (\_\_\_\_\_), both explicitly and implicitly  
9 require software. Since no software is disclosed in the specification, and no meaningful  
10 programming guidance is provided, a person of skill in the art would have to engage a process of  
11 trial and error, perhaps followed by bottom up software development, in order to make and use  
12 the full scope of Claim 8. Claim 8 also fails the enablement requirement in light of the breadth  
13 of the subject matter claimed (e.g. "higher/lower level of security," "execution space identifier,"  
14 "assembling"). The specification does not teach a person of ordinary skill in the art how to  
15 practice the full scope of the claim, and a person of skill in the art would therefore be required to  
16 undertake undue experimentation in order to make and use the invention across the full scope  
17 claimed. For these reasons and for the reasons stated above with respect to all of the claims,  
18 Claim 8 fails the enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

19 Claim 9: Claim 9 is dependent upon Claim 8 and thus fails the enablement and  
20 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
21 the limitation of Claim 9 fails because it requires additional undisclosed software.

22 Claim 13: Claim 13 is dependent upon Claim 8 and thus fails the enablement and  
23 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
24 the limitation of Claim 13 fails because it requires additional undisclosed software. Claim 13 also  
25 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g. "a  
26 security level higher than that of the execution space,"). The specification does not teach a person  
27 of ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the  
28 art would therefore be required to undertake undue experimentation in order to make and use the

1 invention across the full scope claimed.

2           **Claim 14:** Claim 14 is dependent upon Claim 13 and thus fails the enablement  
3 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
4 addition, the limitation of Claim 14 fails because it requires additional undisclosed software.

5           **Claim 35:** Claim 35 of the '912 patent fails the enablement requirement because  
6 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
7 purportedly disclosed invention without undue experimentation in the development of enabling  
8 software. Specifically, several limitations in Claim 35 (330:27-57), both explicitly and implicitly  
9 require software. Since no software is disclosed in the specification, and no meaningful  
10 programming guidance is provided, a person of skill in the art would have to engage a process of  
11 trial and error, perhaps followed by bottom up software development, in order to make and use  
12 the full scope of Claim 35. Claim 35 also fails the enablement requirement in light of the breadth  
13 of the subject matter claimed (e.g. "second processing environment remote from first processing  
14 environment," "identification information"). The specification does not teach a person of  
15 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
16 would therefore be required to undertake undue experimentation in order to make and use the  
17 invention across the full scope claimed. For these reasons and for the reasons stated above with  
18 respect to all of the claims, Claim 35 fails the enablement and written description requirements of  
19 35 U.S.C. § 112 ¶ 1.

20           **The '900 Patent**

21           **Claim 155:** Claim 155 of the '900 patent fails the enablement requirement  
22 because the specification does not teach a person of ordinary skill in the relevant arts how to  
23 practice the purportedly disclosed invention without undue experimentation in the development of  
24 enabling software. Specifically, several limitations in Claim 155 (370:30-55), both explicitly and  
25 implicitly require software. Since no software is disclosed in the specification, and no  
26 meaningful programming guidance is provided, a person of skill in the art would have to engage a  
27 process of trial and error, perhaps followed by bottom up software development, in order to make  
28 and use the full scope of Claim 155. Claim 155 also fails the enablement requirement in light of

1 the breadth of the subject matter claimed (e.g. "host processing environment," "tamper resistant  
2 software designed to be loaded into said main memory . . .," "machine check programming which  
3 derives information . . .," "integrity programming"). The specification does not teach a person of  
4 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
5 would therefore be required to undertake undue experimentation in order to make and use the  
6 invention across the full scope claimed. For these reasons and for the reasons stated above with  
7 respect to all of the claims, Claim 155 fails the enablement and written description requirements  
8 of 35 U.S.C. § 112 ¶ 1.

9           **Claim 156:** Claim 156 of the '900 patent fails the enablement requirement  
10 because the specification does not teach a person of ordinary skill in the relevant arts how to  
11 practice the purportedly disclosed invention without undue experimentation in the development of  
12 enabling software. Specifically, several limitations in Claim 156 (370:57-371:15), both explicitly  
13 and implicitly require software. Since no software is disclosed in the specification, and no  
14 meaningful programming guidance is provided, a person of skill in the art would have to engage a  
15 process of trial and error, perhaps followed by bottom up software development, in order to make  
16 and use the full scope of Claim 156. Claim 156 also fails the enablement requirement in light of  
17 the breadth of the subject matter claimed (e.g. "virtual distribution environment," "host  
18 processing environment," "tamper resistant software designed to be loaded into said main  
19 memory . . .," "machine check programming which derives information . . .," "integrity  
20 programming"). The specification does not teach a person of ordinary skill in the art how to  
21 practice the full scope of the claim, and a person of skill in the art would therefore be required to  
22 undertake undue experimentation in order to make and use the invention across the full scope  
23 claimed. For these reasons and for the reasons stated above with respect to all of the claims,  
24 Claim 156 fails the enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

25           **Claim 157:** Claim 157 of the '900 patent fails the enablement requirement  
26 because the specification does not teach a person of ordinary skill in the relevant arts how to  
27 practice the purportedly disclosed invention without undue experimentation in the development of  
28 enabling software. Specifically, several limitations in Claim 157 (371:16-42), both explicitly and

1 implicitly require software. Since no software is disclosed in the specification, and no  
2 meaningful programming guidance is provided, a person of skill in the art would have to engage a  
3 process of trial and error, perhaps followed by bottom up software development, in order to make  
4 and use the full scope of Claim 157. Claim 157 also fails the enablement requirement in light of  
5 the breadth of the subject matter claimed (e.g. "virtual distribution environment," "host  
6 processing environment," "tamper resistant software designed to be loaded into said main  
7 memory . . .," "machine check programming which derives information . . .," "integrity  
8 programming"). The specification does not teach a person of ordinary skill in the art how to  
9 practice the full scope of the claim, and a person of skill in the art would therefore be required to  
10 undertake undue experimentation in order to make and use the invention across the full scope  
11 claimed. For these reasons and for the reasons stated above with respect to all of the claims,  
12 Claim 157 fails the enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

### 13 The '721 Patent

14 **Claim 1:** Claim 1 of the '721 patent fails the enablement requirement because the  
15 specification does not teach a person of ordinary skill in the relevant arts how to practice the  
16 purportedly disclosed invention without undue experimentation in the development of enabling  
17 software. Specifically, several limitations in Claim 1 (21:10-24), both explicitly and implicitly  
18 require software. Since no software is disclosed in the specification, and no meaningful  
19 programming guidance is provided, a person of skill in the art would have to engage a process of  
20 trial and error, perhaps followed by bottom up software development, in order to make and use  
21 the full scope of Claim 1. Claim 1 also fails the enablement requirement in light of the breadth  
22 of the subject matter claimed (e.g. "load module," "tamper resistance," "security level"). The  
23 specification does not teach a person of ordinary skill in the art how to practice the full scope of  
24 the claim, and a person of skill in the art would therefore be required to undertake undue  
25 experimentation in order to make and use the invention across the full scope claimed. For these  
26 reasons and for the reasons stated above with respect to all of the claims, Claim 1 fails the  
27 enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

28 **Claim 5:** Claim 5 of the '721 patent fails the enablement requirement because the

1 specification does not teach a person of ordinary skill in the relevant arts how to practice the  
2 purportedly disclosed invention without undue experimentation in the development of enabling  
3 software. Specifically, several limitations in Claim 5 (21:39-47), both explicitly and implicitly  
4 require software. Since no software is disclosed in the specification, and no meaningful  
5 programming guidance is provided, a person of skill in the art would have to engage a process of  
6 trial and error, perhaps followed by bottom up software development, in order to make and use  
7 the full scope of Claim 5. Claim 5 also fails the enablement requirement in light of the breadth  
8 of the subject matter claimed (e.g. "software verifying method," "specification"). The  
9 specification does not teach a person of ordinary skill in the art how to practice the full scope of  
10 the claim, and a person of skill in the art would therefore be required to undertake undue  
11 experimentation in order to make and use the invention across the full scope claimed. For these  
12 reasons and for the reasons stated above with respect to all of the claims, Claim 5 fails the  
13 enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

14 **Claim 9:** Claim 9 of the '721 patent fails the enablement requirement because the  
15 specification does not teach a person of ordinary skill in the relevant arts how to practice the  
16 purportedly disclosed invention without undue experimentation in the development of enabling  
17 software. Specifically, several limitations in Claim 9 (22:5-15), both explicitly and implicitly  
18 require software. Since no software is disclosed in the specification, and no meaningful  
19 programming guidance is provided, a person of skill in the art would have to engage a process of  
20 trial and error, perhaps followed by bottom up software development, in order to make and use  
21 the full scope of Claim 9. Claim 9 also fails the enablement requirement in light of the breadth  
22 of the subject matter claimed (e.g. "distinguishing between trusted and untrusted load modules . .  
23 .," "associated digital signature," "conditionally executing"). The specification does not teach a  
24 person of ordinary skill in the art how to practice the full scope of the claim, and a person of skill  
25 in the art would therefore be required to undertake undue experimentation in order to make and  
26 use the invention across the full scope claimed. For these reasons and for the reasons stated  
27 above with respect to all of the claims, Claim 9 fails the enablement and written description  
28 requirements of 35 U.S.C. § 112 ¶ 1.



1           **Claim 14:** Claim 14 of the '721 patent fails the enablement requirement because  
2 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
3 purportedly disclosed invention without undue experimentation in the development of enabling  
4 software. Specifically, several limitations in Claim 14 (22:44-51), both explicitly and implicitly  
5 require software. Since no software is disclosed in the specification, and no meaningful  
6 programming guidance is provided, a person of skill in the art would have to engage a process of  
7 trial and error, perhaps followed by bottom up software development, in order to make and use  
8 the full scope of Claim 14. Claim 14 also fails the enablement requirement in light of the  
9 breadth of the subject matter claimed (e.g. "arrangement within the first tamper resistant barrier  
10 that prevents . . ."). The specification does not teach a person of ordinary skill in the art how to  
11 practice the full scope of the claim, and a person of skill in the art would therefore be required to  
12 undertake undue experimentation in order to make and use the invention across the full scope  
13 claimed. For these reasons and for the reasons stated above with respect to all of the claims,  
14 Claim 14 fails the enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

15           **Claim 18:** Claim 18 of the '721 patent fails the enablement requirement because  
16 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
17 purportedly disclosed invention without undue experimentation in the development of enabling  
18 software. Specifically, several limitations in Claim 18 (22:64-25:3), both explicitly and implicitly  
19 require software. Since no software is disclosed in the specification, and no meaningful  
20 programming guidance is provided, a person of skill in the art would have to engage a process of  
21 trial and error, perhaps followed by bottom up software development, in order to make and use  
22 the full scope of Claim 18. Claim 18 also fails the enablement requirement in light of the  
23 breadth of the subject matter claimed (e.g. "preventing the first computing arrangement . . .").  
24 The specification does not teach a person of ordinary skill in the art how to practice the full scope  
25 of the claim, and a person of skill in the art would therefore be required to undertake undue  
26 experimentation in order to make and use the invention across the full scope claimed. For these  
27 reasons and for the reasons stated above with respect to all of the claims, Claim 18 fails the  
28 enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

1           **Claim 34:** Claim 34 of the '721 patent fails the enablement requirement because  
2 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
3 purportedly disclosed invention without undue experimentation in the development of enabling  
4 software. Specifically, several limitations in Claim 34 (24:47-56), both explicitly and implicitly  
5 require software. Since no software is disclosed in the specification, and no meaningful  
6 programming guidance is provided, a person of skill in the art would have to engage a process of  
7 trial and error, perhaps followed by bottom up software development, in order to make and use  
8 the full scope of Claim 34. Claim 34 also fails the enablement requirement in light of the  
9 breadth of the subject matter claimed (e.g. "secure execution space," "security level"). The  
10 specification does not teach a person of ordinary skill in the art how to practice the full scope of  
11 the claim, and a person of skill in the art would therefore be required to undertake undue  
12 experimentation in order to make and use the invention across the full scope claimed. For these  
13 reasons and for the reasons stated above with respect to all of the claims, Claim 34 fails the  
14 enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

15           **Claim 38:** Claim 38 of the '721 patent fails the enablement requirement because  
16 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
17 purportedly disclosed invention without undue experimentation in the development of enabling  
18 software. Specifically, several limitations in Claim 38 (25:1-8), both explicitly and implicitly  
19 require software. Since no software is disclosed in the specification, and no meaningful  
20 programming guidance is provided, a person of skill in the art would have to engage a process of  
21 trial and error, perhaps followed by bottom up software development, in order to make and use  
22 the full scope of Claim 38. Claim 38 also fails the enablement requirement in light of the  
23 breadth of the subject matter claimed (e.g. "computing arrangement surrounded by a first tamper  
24 resistant barrier . . . ;" "security level"). The specification does not teach a person of ordinary  
25 skill in the art how to practice the full scope of the claim, and a person of skill in the art would  
26 therefore be required to undertake undue experimentation in order to make and use the invention  
27 across the full scope claimed. For these reasons and for the reasons stated above with respect to  
28 all of the claims, Claim 38 fails the enablement and written description requirements of 35 U.S.C.

1 § 112 ¶ 1.

2 The '019 Patent

3 Claim 1: Claim 1 of the '019 patent fails the enablement requirement because the  
4 specification does not teach a person of ordinary skill in the relevant arts how to practice the  
5 purportedly disclosed invention without undue experimentation in the development of enabling  
6 software. Specifically, several limitations in Claim 1 (319:46-320:7), both explicitly and  
7 implicitly require software. Since no software is disclosed in the specification, and no  
8 meaningful programming guidance is provided, a person of skill in the art would have to engage a  
9 process of trial and error, perhaps followed by bottom up software development, in order to make  
10 and use the full scope of Claim 1. Claim 1 also fails the enablement requirement in light of the  
11 breadth of the subject matter claimed (e.g. "associated control," "protected," transferring,"  
12 "protected content file") The specification does not teach a person of ordinary skill in the art how  
13 to practice the full scope of the claim, and a person of skill in the art would therefore be required  
14 to undertake undue experimentation in order to make and use the invention across the full scope  
15 claimed. For these reasons and for the reasons stated above with respect to all of the claims,  
16 Claim 1 fails the enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

17 Claim 33: Claim 33 of the '019 patent fails the enablement requirement because  
18 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
19 purportedly disclosed invention without undue experimentation in the development of enabling  
20 software. Specifically, several limitations in Claim 33 (323:60-324:14), both explicitly and  
21 implicitly require software. Since no software is disclosed in the specification, and no  
22 meaningful programming guidance is provided, a person of skill in the art would have to engage a  
23 process of trial and error, perhaps followed by bottom up software development, in order to make  
24 and use the full scope of Claim 33. Claim 33 also fails the enablement requirement in light of the  
25 breadth of the subject matter claimed (e.g. "means for incorporating," "means for transferring,"  
26 "protected data") The specification does not teach a person of ordinary skill in the art how to  
27 practice the full scope of the claim, and a person of skill in the art would therefore be required to  
28 undertake undue experimentation in order to make and use the invention across the full scope

1 claimed. For these reasons and for the reasons stated above with respect to all of the claims,  
2 Claim 33 fails the enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

3 Claim 34: Claim 34 is dependent upon Claim 33 and thus fails the enablement  
4 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
5 addition, the limitation of Claim 34 fails because it requires additional undisclosed software.  
6 Claim 34 also fails the enablement requirement in light of the breadth of the subject matter  
7 claimed (e.g. "means for applying"). The specification does not teach a person of ordinary skill  
8 in the art how to practice the full scope of the claim, and a person of skill in the art would  
9 therefore be required to undertake undue experimentation in order to make and use the invention  
10 across the full scope claimed.

11 Claim 35: Claim 35 is dependent upon Claim 34 and thus fails the enablement  
12 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
13 addition, the limitation of Claim 35 fails because it requires additional undisclosed software.  
14 Claim 35 also fails the enablement requirement in light of the breadth of the subject matter  
15 claimed (e.g. "means for applying"). The specification does not teach a person of ordinary skill  
16 in the art how to practice the full scope of the claim, and a person of skill in the art would  
17 therefore be required to undertake undue experimentation in order to make and use the invention  
18 across the full scope claimed.

19 Claim 41: Claim 41 of the '019 patent fails the enablement requirement because  
20 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
21 purportedly disclosed invention without undue experimentation in the development of enabling  
22 software. Specifically, several limitations in Claim 41 (325:7-29), both explicitly and implicitly  
23 require software. Since no software is disclosed in the specification, and no meaningful  
24 programming guidance is provided, a person of skill in the art would have to engage a process of  
25 trial and error, perhaps followed by bottom up software development, in order to make and use  
26 the full scope of Claim 41. Claim 41 also fails the enablement requirement in light of the breadth  
27 of the subject matter claimed (e.g. "virtual distribution environment") The specification does not  
28 teach a person of ordinary skill in the art how to practice the full scope of the claim, and a person

1 of skill in the art would therefore be required to undertake undue experimentation in order to  
2 make and use the invention across the full scope claimed. For these reasons and for the reasons  
3 stated above with respect to all of the claims, Claim 41 fails the enablement and written  
4 description requirements of 35 U.S.C. § 112 ¶ 1.

5 Claim 42: Claim 42 is dependent upon Claim 41 and thus fails the enablement  
6 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
7 addition, the limitation of Claim 42 fails because it requires additional undisclosed software.  
8 Claim 42 also fails the enablement requirement in light of the breadth of the subject matter  
9 claimed (e.g. "control," "protected information," "secure container"). The specification does not  
10 teach a person of ordinary skill in the art how to practice the full scope of the claim, and a person  
11 of skill in the art would therefore be required to undertake undue experimentation in order to  
12 make and use the invention across the full scope claimed.

13 Claim 47: Claim 47 is dependent upon Claim 41 and thus fails the enablement  
14 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
15 addition, the limitation of Claim 47 fails because it requires additional undisclosed software.  
16 Claim 47 also fails the enablement requirement in light of the breadth of the subject matter  
17 claimed (e.g. "control"). The specification does not teach a person of ordinary skill in the art how  
18 to practice the full scope of the claim, and a person of skill in the art would therefore be required  
19 to undertake undue experimentation in order to make and use the invention across the full scope  
20 claimed.

21 Claim 52: Claim 52 is dependent upon Claim 41 and thus fails the enablement  
22 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
23 addition, the limitation of Claim 52 fails because it requires additional undisclosed software.  
24 Claim 52 also fails the enablement requirement in light of the breadth of the subject matter  
25 claimed (e.g. "creating" "secure container," "site"). The specification does not teach a person of  
26 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
27 would therefore be required to undertake undue experimentation in order to make and use the  
28 invention across the full scope claimed.

1           **Claim 53:** Claim 53 is dependent upon Claim 52 and thus fails the enablement  
2 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
3 addition, the limitation of Claim 53 fails because it requires additional undisclosed software.  
4 Claim 53 also fails the enablement requirement in light of the breadth of the subject matter  
5 claimed (*e.g.* "associated"). The specification does not teach a person of ordinary skill in the art  
6 how to practice the full scope of the claim, and a person of skill in the art would therefore be  
7 required to undertake undue experimentation in order to make and use the invention across the  
8 full scope claimed.

9           **Claim 54:** Claim 54 is dependent upon Claim 53 and thus fails the enablement  
10 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
11 addition, the limitation of Claim 54 fails because it requires additional undisclosed software.  
12 Claim 54 also fails the enablement requirement in light of the breadth of the subject matter  
13 claimed (*e.g.* "associated"). The specification does not teach a person of ordinary skill in the art  
14 how to practice the full scope of the claim, and a person of skill in the art would therefore be  
15 required to undertake undue experimentation in order to make and use the invention across the  
16 full scope claimed.

17           **Claim 55:** Claim 55 is dependent upon Claim 54 and thus fails the enablement  
18 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
19 addition, the limitation of Claim 55 fails because it requires additional undisclosed software.  
20 Claim 55 also fails the enablement requirement in light of the breadth of the subject matter  
21 claimed (*e.g.* "site"). The specification does not teach a person of ordinary skill in the art how to  
22 practice the full scope of the claim, and a person of skill in the art would therefore be required to  
23 undertake undue experimentation in order to make and use the invention across the full scope  
24 claimed.

25           **Claim 64:** Claim 64 is dependent upon Claim 54 and thus fails the enablement  
26 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
27 addition, the limitation of Claim 64 fails because it requires additional undisclosed software.  
28 Claim 64 also fails the enablement requirement in light of the breadth of the subject matter

1 claimed (e.g. "portion of said first protected information"). The specification does not teach a  
2 person of ordinary skill in the art how to practice the full scope of the claim, and a person of skill  
3 in the art would therefore be required to undertake undue experimentation in order to make and  
4 use the invention across the full scope claimed.

5           **Claim 76:** Claim 76 is dependent upon Claim 41 and thus fails the enablement  
6 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
7 addition, the limitation of Claim 76 fails because it requires additional undisclosed software.  
8 Claim 76 also fails the enablement requirement in light of the breadth of the subject matter  
9 claimed (e.g. "secure container," "contained"). The specification does not teach a person of  
10 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
11 would therefore be required to undertake undue experimentation in order to make and use the  
12 invention across the full scope claimed.

13           **Claim 78:** Claim 78 is dependent upon Claim 52 and thus fails the enablement  
14 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
15 addition, the limitation of Claim 78 fails because it requires additional undisclosed software.  
16 Claim 78 also fails the enablement requirement in light of the breadth of the subject matter  
17 claimed (e.g. "secure container," "contained"). The specification does not teach a person of  
18 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
19 would therefore be required to undertake undue experimentation in order to make and use the  
20 invention across the full scope claimed.

21           **Claim 81:** Claim 81 of the '019 patent fails the enablement requirement because  
22 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
23 purportedly disclosed invention without undue experimentation in the development of enabling  
24 software. Specifically, several limitations in Claim 81 (328:9-23), both explicitly and implicitly  
25 require software. Since no software is disclosed in the specification, and no meaningful  
26 programming guidance is provided, a person of skill in the art would have to engage a process of  
27 trial and error, perhaps followed by bottom up software development, in order to make and use  
28 the full scope of Claim 81. Claim 81 also fails the enablement requirement in light of the breadth

1 of the subject matter claimed (e.g. "means for incorporating") The specification does not teach a  
2 person of ordinary skill in the art how to practice the full scope of the claim, and a person of skill  
3 in the art would therefore be required to undertake undue experimentation in order to make and  
4 use the invention across the full scope claimed. For these reasons and for the reasons stated  
5 above with respect to all of the claims, Claim 81 fails the enablement and written description  
6 requirements of 35 U.S.C. § 112 ¶ 1.

7           Claim 82: Claim 82 is dependent upon Claim 81 and thus fails the enablement  
8 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
9 addition, the limitation of Claim 82 fails because it requires additional undisclosed software.  
10 Claim 82 also fails the enablement requirement in light of the breadth of the subject matter  
11 claimed (e.g. "means for applying," "govern"). The specification does not teach a person of  
12 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
13 would therefore be required to undertake undue experimentation in order to make and use the  
14 invention across the full scope claimed.

15           Claim 83: Claim 83 is dependent upon Claim 82 and thus fails the enablement  
16 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
17 addition, the limitation of Claim 83 fails because it requires additional undisclosed software.  
18 Claim 83 also fails the enablement requirement in light of the breadth of the subject matter  
19 claimed (e.g. "govern," "means for applying"). The specification does not teach a person of  
20 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
21 would therefore be required to undertake undue experimentation in order to make and use the  
22 invention across the full scope claimed.

23           Claim 85: Claim 85 of the '019 patent fails the enablement requirement because  
24 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
25 purportedly disclosed invention without undue experimentation in the development of enabling  
26 software. Specifically, several limitations in Claim 85 (328:28-56), both explicitly and implicitly  
27 require software. Since no software is disclosed in the specification, and no meaningful  
28 programming guidance is provided, a person of skill in the art would have to engage a process of



1 trial and error, perhaps followed by bottom up software development, in order to make and use  
2 the full scope of Claim 85. Claim 85 also fails the enablement requirement in light of the breadth  
3 of the subject matter claimed (e.g. "creating," "copying," "transferring"). The specification does  
4 not teach a person of ordinary skill in the art how to practice the full scope of the claim, and a  
5 person of skill in the art would therefore be required to undertake undue experimentation in order  
6 to make and use the invention across the full scope claimed. For these reasons and for the reasons  
7 stated above with respect to all of the claims, Claim 85 fails the enablement and written  
8 description requirements of 35 U.S.C. § 112 ¶ 1.

9 Claim 87: Claim 87 is dependent upon Claim 85 and thus fails the enablement  
10 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
11 addition, the limitation of Claim 87 fails because it requires additional undisclosed software.  
12 Claim 87 also fails the enablement requirement in light of the breadth of the subject matter  
13 claimed (e.g. "copied," "protected information"). The specification does not teach a person of  
14 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
15 would therefore be required to undertake undue experimentation in order to make and use the  
16 invention across the full scope claimed.

17 Claim 89: Claim 89 is dependent upon Claim 85 and thus fails the enablement  
18 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
19 addition, the limitation of Claim 89 fails because it requires additional undisclosed software.  
20 Claim 89 also fails the enablement requirement in light of the breadth of the subject matter  
21 claimed (e.g. "copying," "transferring"). The specification does not teach a person of ordinary  
22 skill in the art how to practice the full scope of the claim, and a person of skill in the art would  
23 therefore be required to undertake undue experimentation in order to make and use the invention  
24 across the full scope claimed.

25 Claim 90: Claim 90 is dependent upon Claim 85 and thus fails the enablement  
26 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
27 addition, the limitation of Claim 90 fails because it requires additional undisclosed software.  
28 Claim 90 also fails the enablement requirement in light of the breadth of the subject matter

1 claimed (e.g. "memory"). The specification does not teach a person of ordinary skill in the art  
2 how to practice the full scope of the claim, and a person of skill in the art would therefore be  
3 required to undertake undue experimentation in order to make and use the invention across the  
4 full scope claimed.

5           **Claim 93:** Claim 93 is dependent upon Claim 85 and thus fails the enablement  
6 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
7 addition, the limitation of Claim 93 fails because it requires additional undisclosed software.  
8 Claim 93 also fails the enablement requirement in light of the breadth of the subject matter  
9 claimed (e.g. "copying transferring"). The specification does not teach a person of ordinary skill  
10 in the art how to practice the full scope of the claim, and a person of skill in the art would  
11 therefore be required to undertake undue experimentation in order to make and use the invention  
12 across the full scope claimed.

13           **Claim 94:** Claim 94 is dependent upon Claim 85 and thus fails the enablement  
14 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
15 addition, the limitation of Claim 89 fails because it requires additional undisclosed software.

16           **Claim 95:** Claim 95 is dependent upon Claim 94 and thus fails the enablement  
17 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
18 addition, the limitation of Claim 95 fails because it requires additional undisclosed software.  
19 Claim 95 also fails the enablement requirement in light of the breadth of the subject matter  
20 claimed (e.g. "copied," "protected information"). The specification does not teach a person of  
21 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
22 would therefore be required to undertake undue experimentation in order to make and use the  
23 invention across the full scope claimed.

24           **Claim 96:** Claim 96 of the '019 patent fails the enablement requirement because  
25 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
26 purportedly disclosed invention without undue experimentation in the development of enabling  
27 software. Specifically, several limitations in Claim 96 (329:38-330:12), both explicitly and  
28 implicitly require software. Since no software is disclosed in the specification, and no

1 meaningful programming guidance is provided, a person of skill in the art would have to engage a  
2 process of trial and error, perhaps followed by bottom up software development, in order to make  
3 and use the full scope of Claim 96. Claim 96 also fails the enablement requirement in light of the  
4 breadth of the subject matter claimed (e.g. "virtual distribution environment," "protected  
5 information") The specification does not teach a person of ordinary skill in the art how to  
6 practice the full scope of the claim, and a person of skill in the art would therefore be required to  
7 undertake undue experimentation in order to make and use the invention across the full scope  
8 claimed. For these reasons and for the reasons stated above with respect to all of the claims,  
9 Claim 96 fails the enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

#### 10 The '876 Patent

11 Claim 2: Claim 2 of the '876 patent fails the enablement requirement because the  
12 specification does not teach a person of ordinary skill in the relevant arts how to practice the  
13 purportedly disclosed invention without undue experimentation in the development of enabling  
14 software. Specifically, several limitations in Claim 2 (319:20-32), both explicitly and implicitly  
15 require software. Since no software is disclosed in the specification, and no meaningful  
16 programming guidance is provided, a person of skill in the art would have to engage a process of  
17 trial and error, perhaps followed by bottom up software development, in order to make and use  
18 the full scope of Claim 2. Claim 2 also fails the enablement requirement in light of the breadth  
19 of the subject matter claimed (e.g. "means for . . . securely integrating," "value chain extended  
20 agreement"). The specification does not teach a person of ordinary skill in the art how to practice  
21 the full scope of the claim, and a person of skill in the art would therefore be required to  
22 undertake undue experimentation in order to make and use the invention across the full scope  
23 claimed. For these reasons and for the reasons stated above with respect to all of the claims,  
24 Claim 2 fails the enablement and written description requirements of 35 U.S.C. § 112 ¶ 1.

25 Claim 11: Claim 11 is dependent upon Claim 2 and thus fails the enablement and  
26 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
27 the limitation of Claim 11 fails because it requires additional undisclosed software. Claim 11 also  
28 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g.

1 "Virtual Distribution Environment"). The specification does not teach a person of ordinary skill  
2 in the art how to practice the full scope of the claim, and a person of skill in the art would  
3 therefore be required to undertake undue experimentation in order to make and use the invention  
4 across the full scope claimed.

5 Claim 29: Claim 29 is dependent upon Claim 2 and thus fails the enablement and  
6 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
7 the limitation of Claim 29 fails because it requires additional undisclosed software. Claim 29 also  
8 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g. "secure  
9 control," "required terms"). The specification does not teach a person of ordinary skill in the art  
10 how to practice the full scope of the claim, and a person of skill in the art would therefore be  
11 required to undertake undue experimentation in order to make and use the invention across the  
12 full scope claimed.

13 Claim 32: Claim 32 is dependent upon Claim 2 and thus fails the enablement and  
14 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
15 the limitation of Claim 32 fails because it requires additional undisclosed software. Claim 32 also  
16 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g. "secure  
17 control," "required terms"). The specification does not teach a person of ordinary skill in the art  
18 how to practice the full scope of the claim, and a person of skill in the art would therefore be  
19 required to undertake undue experimentation in order to make and use the invention across the  
20 full scope claimed.

21 Claim 60: Claim 60 is dependent upon Claim 2 and thus fails the enablement and  
22 written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In addition,  
23 the limitation of Claim 60 fails because it requires additional undisclosed software. Claim 60 also  
24 fails the enablement requirement in light of the breadth of the subject matter claimed (e.g. "secure  
25 control," "required terms"). The specification does not teach a person of ordinary skill in the art  
26 how to practice the full scope of the claim, and a person of skill in the art would therefore be  
27 required to undertake undue experimentation in order to make and use the invention across the  
28 full scope claimed.

1           **Claim 130:** Claim 130 is dependent upon Claim 2 and thus fails the enablement  
2 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
3 addition, the limitation of Claim 29 fails because it requires additional undisclosed software.  
4 Claim 29 also fails the enablement requirement in light of the breadth of the subject matter  
5 claimed (e.g. "means for executing . . . control"). The specification does not teach a person of  
6 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
7 would therefore be required to undertake undue experimentation in order to make and use the  
8 invention across the full scope claimed.

9           **Claim 132:** Claim 132 is dependent upon Claim 130 and thus fails the enablement  
10 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
11 addition, the limitation of Claim 132 fails because it requires additional undisclosed software.  
12 Claim 132 also fails the enablement requirement in light of the breadth of the subject matter  
13 claimed (e.g. "protected processing environment"). The specification does not teach a person of  
14 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
15 would therefore be required to undertake undue experimentation in order to make and use the  
16 invention across the full scope claimed.

17           **Claim 161:** Claim 161 is dependent upon Claim 2 and thus fails the enablement  
18 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
19 addition, the limitation of Claim 161 fails because it requires additional undisclosed software.  
20 Claim 161 also fails the enablement requirement in light of the breadth of the subject matter  
21 claimed (e.g. "machine executable controls"). The specification does not teach a person of  
22 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
23 would therefore be required to undertake undue experimentation in order to make and use the  
24 invention across the full scope claimed.

25           **Claim 162:** Claim 162 is dependent upon Claim 161 and thus fails the enablement  
26 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
27 addition, the limitation of Claim 162 fails because it requires additional undisclosed software  
28 Claim 162 also fails the enablement requirement in light of the breadth of the subject matter

1 claimed (e.g. "data descriptor data structures"). The specification does not teach a person of  
2 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
3 would therefore be required to undertake undue experimentation in order to make and use the  
4 invention across the full scope claimed.

5 Claim 170: Claim 170 is dependent upon Claim 2 and thus fails the enablement  
6 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
7 addition, the limitation of Claim 170 fails because it requires additional undisclosed software.  
8 Claim 170 also fails the enablement requirement in light of the breadth of the subject matter  
9 claimed (e.g. "means for creating a first secure control"). The specification does not teach a  
10 person of ordinary skill in the art how to practice the full scope of the claim, and a person of skill  
11 in the art would therefore be required to undertake undue experimentation in order to make and  
12 use the invention across the full scope claimed.

13 Claim 171: Claim 171 is dependent upon Claim 2 and thus fails the enablement  
14 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
15 addition, the limitation of Claim 171 fails because it requires additional undisclosed software.  
16 Claim 171 also fails the enablement requirement in light of the breadth of the subject matter  
17 claimed (e.g. "means for creating . . . secure control"). The specification does not teach a person  
18 of ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the  
19 art would therefore be required to undertake undue experimentation in order to make and use the  
20 invention across the full scope claimed.

21 Claim 172: Claim 172 is dependent upon Claim 2 and thus fails the enablement  
22 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
23 addition, the limitation of Claim 172 fails because it requires additional undisclosed software.  
24 Claim 172 also fails the enablement requirement in light of the breadth of the subject matter  
25 claimed (e.g. "means . . . for securely integrating"). The specification does not teach a person of  
26 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
27 would therefore be required to undertake undue experimentation in order to make and use the  
28 invention across the full scope claimed.

1           **Claim 329:** Claim 329 is dependent upon Claim 2 and thus fails the enablement  
2 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
3 addition, the limitation of Claim 329 fails because it requires additional undisclosed software.  
4 Claim 329 also fails the enablement requirement in light of the breadth of the subject matter  
5 claimed (*e.g.* "means for creating . . . secure control"). The specification does not teach a person  
6 of ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the  
7 art would therefore be required to undertake undue experimentation in order to make and use the  
8 invention across the full scope claimed.

9           **Claim 331:** Claim 331 is dependent upon Claim 2 and thus fails the enablement  
10 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
11 addition, the limitation of Claim 331 fails because it requires additional undisclosed software.  
12 Claim 331 also fails the enablement requirement in light of the breadth of the subject matter  
13 claimed (*e.g.* "means . . . for securely integrating," "based on or compatible with . . ."). The  
14 specification does not teach a person of ordinary skill in the art how to practice the full scope of  
15 the claim, and a person of skill in the art would therefore be required to undertake undue  
16 experimentation in order to make and use the invention across the full scope claimed.

17           **Claim 346:** Claim 346 is dependent upon Claim 2 and thus fails the enablement  
18 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
19 addition, the limitation of Claim 346 fails because it requires additional undisclosed software.  
20 Claim 346 also fails the enablement requirement in light of the breadth of the subject matter  
21 claimed (*e.g.* "means by which said third control set governs . . ."). The specification does not  
22 teach a person of ordinary skill in the art how to practice the full scope of the claim, and a person  
23 of skill in the art would therefore be required to undertake undue experimentation in order to  
24 make and use the invention across the full scope claimed.

25           **Claim 347:** Claim 347 is dependent upon Claim 2 and thus fails the enablement  
26 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
27 addition, the limitation of Claim 347 fails because it requires additional undisclosed software.  
28 Claim 347 also fails the enablement requirement in light of the breadth of the subject matter

1 claimed (e.g. "means by which said third control set governs the execution of at least one  
2 method"). The specification does not teach a person of ordinary skill in the art how to practice  
3 the full scope of the claim, and a person of skill in the art would therefore be required to  
4 undertake undue experimentation in order to make and use the invention across the full scope  
5 claimed.

6 Claim 349: Claim 349 is dependent upon Claim 2 and thus fails the enablement  
7 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
8 addition, the limitation of Claim 349 fails because it requires additional undisclosed software.  
9 Claim 349 also fails the enablement requirement in light of the breadth of the subject matter  
10 claimed (e.g. "means by which said third control set governs the execution of at least one  
11 procedure"). The specification does not teach a person of ordinary skill in the art how to practice  
12 the full scope of the claim, and a person of skill in the art would therefore be required to  
13 undertake undue experimentation in order to make and use the invention across the full scope  
14 claimed.

#### 15 The '181 Patent

16 Claim 48: Claim 48 of the '181 patent fails the enablement requirement because  
17 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
18 purportedly disclosed invention without undue experimentation in the development of enabling  
19 software. Specifically, several limitations in Claim 48 (48:17-38), both explicitly and implicitly  
20 require software. Since no software is disclosed in the specification, and no meaningful  
21 programming guidance is provided, a person of skill in the art would have to engage a process of  
22 trial and error, perhaps followed by bottom up software development, in order to make and use  
23 the full scope of Claim 48. Claim 48 also fails the enablement requirement in light of the breadth  
24 of the subject matter claimed (e.g. "narrowcasting selected digital information," "secure node,"  
25 "information derived in part from specified recipient's creation"). The specification does not  
26 teach a person of ordinary skill in the art how to practice the full scope of the claim, and a person  
27 of skill in the art would therefore be required to undertake undue experimentation in order to  
28 make and use the invention across the full scope claimed. For these reasons and for the reasons



1 stated above with respect to all of the claims, Claim 48 fails the enablement and written  
2 description requirements of 35 U.S.C. § 112 ¶ 1.

3 Claim 59: Claim 59 is dependent upon Claim 48 and thus fails the enablement  
4 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
5 addition, the limitation of Claim 59 fails because it requires additional undisclosed software.  
6 Claim 59 also fails the enablement requirement in light of the breadth of the subject matter  
7 claimed. The specification does not teach a person of ordinary skill in the art how to practice the  
8 full scope of the claim, and a person of skill in the art would therefore be required to undertake  
9 undue experimentation in order to make and use the invention across the full scope claimed.

10 Claim 61: Claim 61 is dependent upon Claim 48 and thus fails the enablement  
11 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
12 addition, the limitation of Claim 61 fails because it requires additional undisclosed software.  
13 Claim 61 also fails the enablement requirement in light of the breadth of the subject matter  
14 claimed (*e.g.* "entertainment information"). The specification does not teach a person of ordinary  
15 skill in the art how to practice the full scope of the claim, and a person of skill in the art would  
16 therefore be required to undertake undue experimentation in order to make and use the invention  
17 across the full scope claimed.

18 Claim 63: Claim 63 is dependent upon Claim 48 and thus fails the enablement  
19 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
20 addition, the limitation of Claim 63 fails because it requires additional undisclosed software.  
21 Claim 63 also fails the enablement requirement in light of the breadth of the subject matter  
22 claimed (*e.g.* "music information"). The specification does not teach a person of ordinary skill in  
23 the art how to practice the full scope of the claim, and a person of skill in the art would therefore  
24 be required to undertake undue experimentation in order to make and use the invention across the  
25 full scope claimed.

26 Claim 67: Claim 67 is dependent upon Claim 48 and thus fails the enablement  
27 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
28 addition, the limitation of Claim 67 fails because it requires additional undisclosed software.

1 Claim 67 also fails the enablement requirement in light of the breadth of the subject matter  
2 claimed (e.g. "digital certificate information"). The specification does not teach a person of  
3 ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the art  
4 would therefore be required to undertake undue experimentation in order to make and use the  
5 invention across the full scope claimed.

6 Claim 70: Claim 70 is dependent upon Claim 48 and thus fails the enablement  
7 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
8 addition, the limitation of Claim 70 fails because it requires additional undisclosed software.  
9 Claim 70 also fails the enablement requirement in light of the breadth of the subject matter  
10 claimed. The specification does not teach a person of ordinary skill in the art how to practice the  
11 full scope of the claim, and a person of skill in the art would therefore be required to undertake  
12 undue experimentation in order to make and use the invention across the full scope claimed.

13 Claim 72: Claim 72 is dependent upon Claim 48 and thus fails the enablement  
14 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
15 addition, the limitation of Claim 72 fails because it requires additional undisclosed software.  
16 Claim 72 also fails the enablement requirement in light of the breadth of the subject matter  
17 claimed. The specification does not teach a person of ordinary skill in the art how to practice the  
18 full scope of the claim, and a person of skill in the art would therefore be required to undertake  
19 undue experimentation in order to make and use the invention across the full scope claimed.

20 Claim 75: Claim 75 is dependent upon Claim 72 and thus fails the enablement  
21 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
22 addition, the limitation of Claim 75 fails because it requires additional undisclosed software.  
23 Claim 75 also fails the enablement requirement in light of the breadth of the subject matter  
24 claimed (e.g. "acceptable clearinghouse," "rights and permissions clearinghouse"). The  
25 specification does not teach a person of ordinary skill in the art how to practice the full scope of  
26 the claim, and a person of skill in the art would therefore be required to undertake undue  
27 experimentation in order to make and use the invention across the full scope claimed.

28 Claim 89: Claim 89 is dependent upon Claim 48 and thus fails the enablement

1 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above.

2           **Claim 91:** Claim 91 of the '181 patent fails the enablement requirement because  
3 the specification does not teach a person of ordinary skill in the relevant arts how to practice the  
4 purportedly disclosed invention without undue experimentation in the development of enabling  
5 software. Specifically, several limitations in Claim 91 (86:47-87:4), both explicitly and implicitly  
6 require software. Since no software is disclosed in the specification, and no meaningful  
7 programming guidance is provided, a person of skill in the art would have to engage a process of  
8 trial and error, perhaps followed by bottom up software development, in order to make and use  
9 the full scope of Claim 91. Claim 91 also fails the enablement requirement in light of the breadth  
10 of the subject matter claimed (e.g. "narrowcasting selected digital information," "secure node,"  
11 "information derived in part from specified recipient entity's creation"). The specification does  
12 not teach a person of ordinary skill in the art how to practice the full scope of the claim, and a  
13 person of skill in the art would therefore be required to undertake undue experimentation in order  
14 to make and use the invention across the full scope claimed. For these reasons and for the reasons  
15 stated above with respect to all of the claims, Claim 91 fails the enablement and written  
16 description requirements of 35 U.S.C. § 112 ¶ 1.

17           **Claim 104:** Claim 104 is dependent upon Claim 91 and thus fails the enablement  
18 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
19 addition, the limitation of Claim 104 fails because it requires additional undisclosed software.  
20 Claim 104 also fails the enablement requirement in light of the breadth of the subject matter  
21 claimed. The specification does not teach a person of ordinary skill in the art how to practice the  
22 full scope of the claim, and a person of skill in the art would therefore be required to undertake  
23 undue experimentation in order to make and use the invention across the full scope claimed.

24           **Claim 109:** Claim 109 is dependent upon Claim 91 and thus fails the enablement  
25 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
26 addition, the limitation of Claim 109 fails because it requires additional undisclosed software.  
27 Claim 109 also fails the enablement requirement in light of the breadth of the subject matter  
28 claimed. The specification does not teach a person of ordinary skill in the art how to practice the

1 full scope of the claim, and a person of skill in the art would therefore be required to undertake  
2 undue experimentation in order to make and use the invention across the full scope claimed.

3 Claim 114: Claim 114 is dependent upon Claim 91 and thus fails the enablement  
4 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
5 addition, the limitation of Claim 114 fails because it requires additional undisclosed software.  
6 Claim 114 also fails the enablement requirement in light of the breadth of the subject matter  
7 claimed (e.g. "clearinghouse acceptable to rightsholders"). The specification does not teach a  
8 person of ordinary skill in the art how to practice the full scope of the claim, and a person of skill  
9 in the art would therefore be required to undertake undue experimentation in order to make and  
10 use the invention across the full scope claimed.

11 Claim 117: Claim 117 is dependent upon Claim 114 and thus fails the enablement  
12 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above. In  
13 addition, the limitation of Claim 117 fails because it requires additional undisclosed software.  
14 Claim 117 also fails the enablement requirement in light of the breadth of the subject matter  
15 claimed (e.g. "rights and permissions clearinghouse"). The specification does not teach a person  
16 of ordinary skill in the art how to practice the full scope of the claim, and a person of skill in the  
17 art would therefore be required to undertake undue experimentation in order to make and use the  
18 invention across the full scope claimed.

19 Claim 131: Claim 131 is dependent upon Claim 91 and thus fails the enablement  
20 and written description requirements of 35 U.S.C. § 112 ¶ 1 for the reasons stated above.

### 21 The '402 Patent

22 Claim 1: Claim 1 of the '402 patent fails the enablement requirement because the  
23 specification does not teach a person of ordinary skill in the relevant arts how to practice the  
24 purportedly disclosed invention without undue experimentation in the development of enabling  
25 software. Specifically, several limitations in Claim 1 (322:5-25), both explicitly and implicitly  
26 require software. Since no software is disclosed in the specification, and no meaningful  
27 programming guidance is provided, a person of skill in the art would have to engage a process of  
28 trial and error, perhaps followed by bottom up software development, in order to make and use

1 the full scope of Claim 1. Claim 1 also fails the enablement requirement in light of the breadth  
2 of the subject matter claimed (e.g. "creating," "having associated a first control" "value chain  
3 extended agreement," "transferring"). The specification does not teach a person of ordinary skill  
4 in the art how to practice the full scope of the claim, and a person of skill in the art would  
5 therefore be required to undertake undue experimentation in order to make and use the invention  
6 across the full scope claimed. For these reasons and for the reasons stated above with respect to  
7 all of the claims, Claim 1 fails the enablement and written description requirements of 35 U.S.C.  
8 § 112 ¶ 1.

9 **IV. Patent L.R. 3-4**

10 Each reference identified pursuant to PLR 3-3(a) but not in the prosecution history,  
11 and the documents referenced in PLR 3-4 that are sufficient to show the operation of the accused  
12 features of the products specifically and properly identified in InterTrust's PLR 3-1 Statements of  
13 September 2, 2003, has been or is being produced, or is otherwise available for inspection and  
14 copying. As set forth in greater detail in Microsoft's Motion to Strike InterTrust's Infringement  
15 Contentions (filed October 8, 2003), InterTrust's Infringement Contentions pursuant to PLR 3-1  
16 largely fail to properly identify the "accused instrumentalities." Accordingly, Microsoft reserves  
17 its right to modify this production, if necessary. Microsoft has specifically sought, and has been  
18 granted, greater protection and confidentiality for its source code than that provided by Patent  
19 Local Rule 2-2. Source code for the Accused Instrumentalities is being made available for  
20 inspection at the offices of Orrick, Herrington & Sutcliffe LLP only in accordance with

21 ///

22 ///

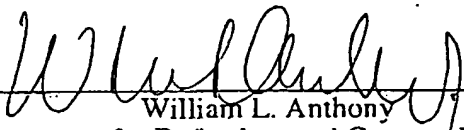
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1 Magistrate James' Order of November 5, 2003. Microsoft does not concede that any source code  
2 made available for inspection (or any corresponding product or software) is or should be  
3 considered an Accused Instrumentality.

4  
5 Dated: November 17, 2003

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